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NO. 806

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

WAYNE KNITTING MILLS AND THE MAY CORPORATION,
Petitioners

vs.

RUSSELL HOSIERY MILLS, INC., *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT AND APPENDIX

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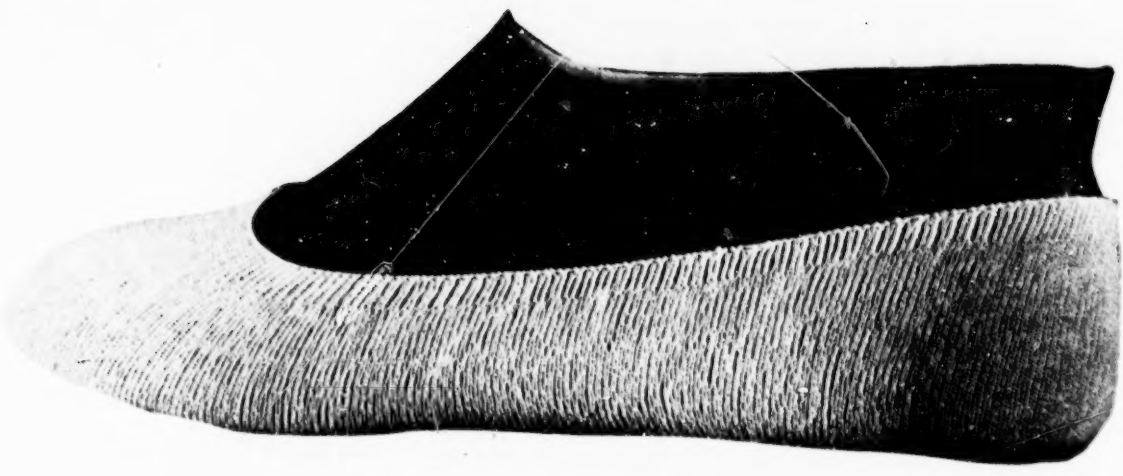
Petitioners' **SONLINER** foot sock
(Plaintiffs' Exhibit No. 2)

i) Flat

ii) On foot form



Petitioners' SONLINER foot sock
(Plaintiffs' Exhibit No. 2)

iii) On foot form within the shoe

IN THE

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NO. ____

WAYNE KNITTING MILLS AND THE MAY CORPORATION,
Petitioners

VS.

RUSSELL HOSIERY MILLS, INC., *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

To the Honorable, The Chief Justice of the United States and the Associate Justices of the Supreme Court of the United States:

Petitioners respectfully pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Fourth Circuit reversing a final judgment of the United States District Court for the Middle District of North Carolina, wherein originally the petitioners were plaintiff and the respondent was defendant.

OPINIONS BELOW

The opinion and judgment of the United States Court of Appeals for the Fourth Circuit appear as Appendix A and Appendix B to this petition. The opinion and judgment of the United States District Court for the Middle District of

North Carolina are reported at 274 F. Supp 934 and appear at pages 2-22 of the respondent's Appendix for Appellant filed in the Court of Appeals.[1]

JURISDICTION

The opinion and judgment sought to be reviewed were entered by the United States Court of Appeals for the Fourth Circuit on September 10, 1968, were reported at 400 F.2d 964 and appear as Appendix A and Appendix B of this petition. The jurisdiction of this Court to review by writ of certiorari the judgment in question is conferred by Title 28, United States Code, Section 1254(1).

QUESTIONS PRESENTED

(1) Did the Court of Appeals err in reversing the trial court by holding that the specification and drawings of the patent in suit could not be referred to for the purpose of construing the claim in issue so as to avoid overclaiming?

(2) Did the Court of Appeals err in reversing the trial court by imposing too stringent and unduly harsh a test of particularity in holding that 35 U.S.C. § 112 requires the claim in suit to specify the particular location of the laid-in rubber rim on the foot of a wearer?

STATEMENT OF THE CASE

The product of the Sarbo patent in suit is a knitted article of ladies' footwear designed to be worn on the foot without showing above the top of the shoe, to give the "bare legged" look when worn (as it customarily is) without conventional socks or hosiery. An actual ladies' foot sock, produced according to the invention, is presented in the Index p. V;

[1] Copies of the record in the district court as printed for use in the United States Court of Appeals for the Fourth Circuit are filed herewith by stipulation, pursuant to Rule 21(1). Such record consists of a gray pamphlet labeled "Appendix for Appellant" and a blue pamphlet labeled "Appendix for Appellee." Because of the length of the District Court Opinion, it is not reproduced as a separate appendix to this petition, but appears at DA 2-22, pursuant to the authority of Rule 23(i).

photographs of this footsock appear in the Index pp. iii and iv; also in Appendix for Appellee, pp. 205 and 206.

The subject matter of the patent in suit was developed by Edgar G. Sarbo in Vienna, Austria in 1958. Sarbo is a naturalized U. S. citizen by virtue of combat service in the United States Army in World War II. Prior to his invention, shoe-top-length foot socks adapted for wear with low cut shoes were available in the market in two forms:

1) a sock such as "Peds" and "Footlets" (Photographs: Appendix for Appellee 225-227) made from flat knitted fabric (as distinguished from tubular seamless knitted fabric as in the Sarbo sock) which was cut from such fabric and then sewn into the desired shape and provided with a sewn-in elastic rim around the foot entry opening, and

2) a sock such as respondent's style 6335 (Photograph: Appendix for Appellee 224) knitted as a conventional sock with a short top with reciprocartorily knit heel and toe pockets, which sock would thereafter be cut down at the top and instep and provided with a sewn-in elastic rim around the foot entry opening. Finding of Fact 4, Appendix for Appellant 6.

Thus, each of these prior art types of socks involved cutting of the fabric, and each involved the sewing in of a heavy elastic band around the foot entry opening. These shoe-top-length foot socks were not only comparatively expensive to manufacture, due to the fact that the cutting and sewing had to be performed in addition to slow reciprocation, but also, were rather uncomfortable by reason of the fact that the heavy band or rim of elastic provided around the foot opening tended to burrow into the foot of the wearer due to the pressure of the shoe. Cutting and sewing is a time consuming operation requiring skilled operators and entailing considerable waste. Finding of Fact 4, Appendix for Appellant 6.

In early 1958, Sarbo, a sock manufacturer who was not engaged in manufacturing shoe-top-length foot socks, became aware of the deficiencies of the available shoe-top-

length foot socks. Sarbo approached the problem as one to be solved within the capabilities of his operations and his machinery, which did not employ cutting and sewing operations, and finally, conceived of his invention. Appendix for Appellant 41.

The significance of Sarbo's invention became apparent immediately, and on November 19, 1958, Sarbo filed an application for Letters Patent in Austria. Thereafter, on November 12, 1959, Sarbo filed a corresponding patent application in the United States which eventually matured into the Sarbo patent in the suit, No. 3,059,458, Appendix C herewith and Appendix for Appellant, pp. 23-25. The United States application was prepared upon the instruction of Sarbo's Austrian attorneys and, so far as Sarbo understood, in accordance with the requirements of the United States patent laws.

In addition to Austria and the United States, patents on Sarbo's invention have also been granted by Argentina, Belgium, Canada, Denmark, Finland, France, Germany, Great Britain, Greece, Italy, Luxemburg, Norway, Spain, Sweden and Switzerland. In addition to granting rights to others under his United States patent, Sarbo had already licensed his patent rights in Germany, Spain and Switzerland at the time of trial. Findings of Fact 7 & 8, Appendix for Appellant 8. The petitioner, Wayne Knitting Mills, is the assignee of the United States patent by mesne conveyances. Findings of Fact 1 & 2, Appendix for Appellant 5.

Just when respondent Russell first became interested in the shoe-top-length foot sock field is not clear from the record. However, sometime prior to 1964, Russell did enter the field with a cut and sewn shoe-top-length foot sock.

In 1964, Russell saw one of May's Sarbo-type foot covers and, after some experimentation, developed and thereafter commenced selling its Style 1335A, which style was *identical* to the May product in every material respect and employed every element of Claim 3 of the Sarbo patent. Appendix for Appellee 48,60. Photographs of the Style 1335A sock ap-

pear at Appendix for Appellee, p. 207.

After formal notice of infringement of the Sarbo patent, Russell thereafter devised two additional Sarbo-type socks, Style 1334B and Style 1334C, one of the purposes for doing so admittedly being to avoid infringement of the Sarbo patent. Stipulation of Fact 44, Appendix for Appellant 123. A photograph of Style 1334C appears at Appendix for Appellant, p. 208. Style 1334B involves reciprocatory knitting and at the time of trial had never been commercially produced and has not been placed in issue in this case. Style 1334C incorporates a 50 denier, two-ply yarn in the upper body portion and a 70 denier, two-ply yarn in the lower body portion, the stitches from the 70 denier yarn being drawn slightly longer than those from the 50 denier yarn. Except for these changes, Style 1334C is identical to Style 1334A, and all of the elements of Claim 3 of the Sarbo patent are also found in Style 1334C. Appendix for Appellant 37-38; 59-61.

Suit for infringement was instituted by the petitioner in the United States District Court for the Middle District of North Carolina under Title 28, § 1338(a) of the United States Code. The trial court held that patent was valid and infringed by the respondent. On appeal by the respondent, the trial court's judgment was reversed by the Court of Appeals on the ground that the claim in suit is invalid for overclaiming and for indefiniteness under 35 U.S.C. § 112.

Another suit for infringement has been initiated by Petitioner in the United States District Court for the Western District of North Carolina (Charlotte), also under Title 28, § 1338(a) of the United States Code. Trial of this suit styled *May Hosiery Mills et al* v. *Moretz Hosiery Mills, Inc. et al* (Civil Action No. 2014) awaits this Court's decision upon the present petition.

REASONS FOR ALLOWANCE OF WRIT

Introduction

This is a case in which the United States Court of Appeals for the Fourth Circuit, in overthrowing the trial court's

finding of validity, improperly and contrary to the decisions of this Court, refused to interpret the claim in suit by reference to the four corners of the patent, *i.e.*, the drawings and specification, and imposed much too rigorous and stringent a test for construing the language of the claim in determining whether or not it satisfied the requirements of Section 112 of Title 35. In doing so, the Court of Appeals decided an important question of federal law in a way in conflict with applicable decisions of this Court and also in conflict with principles of law enunciated in decisions of other Circuit Courts of Appeals.

The following three paragraphs which conclude the opinion of the Court of Appeals in this case are critical to the understanding of this petition and the petitioner sets them out for the convenience of the Court:

> "From plaintiffs' argument and the district judge's conclusion, it is apparent that the lower location where the laid-in rubber rim serves its function is critical to the validity of Sarbo Claim 3, both as to inobviousness and new function. Yet, the exact location of the rim is not identified anywhere in the claim. At most, the claim implies a location below the ankle, but plaintiffs and the court below predicate the validity of the claim, not on the entire area below the ankle, but on the undetermined location below the ankle where the ankle ceases to resemble the cylindrical conformation of the leg and exhibits the irregular configuration of the foot. Specifically, Sarbo Claim 3 gives no particularity as to the part or shape of the foot or leg portion the rim contracts against or where it is located relative to the instep. While this claim recites that the body does function as "tip, sole and heel portions" of the foot cover, absent is any language to exclude the body from also covering part of the instep, the ankle or parts of the foot in the area below the ankle.
>
> Lacking language disclosing how the patented device should be constructed so as to position the elasticized rim below the ankle in the place where it can perform its theretofore undiscovered—and hence new and novel —function, the claim, in our view, is invalid, because it is so broad that it claims as invention that which

plaintiffs concede was not new. Stated otherwise, by the breadth of the claim that which is conceded to have been known in the prior art—that which the prior art anticipated or made obvious—is included within the claimed invention; hence, the claim is invalid for overclaiming. *Schriber-Sibroth Co.* v. *Cleveland Trust Co.*, 305 U.S. 47 (1938). See also, *Heyl & Patterson, Incorporated* v. *McDowell Company*, 317 F.2d 719 (4 Cir. 1963). And the drawings cannot properly be referred to for the purpose of narrowing the claim. *Binks Mfg. Co.* v. *Ransburg Electro-Coating Corp.*, 281 F.2d 252, 256 (7 Cir. 1960). Cf. *Wilcox Manufacturing Co.* v. *Eastern Gas & Fuel Associates*, 400 F.2d 960 (4 Cir., Decided Sept. 10, 1968.)

It follows, also, that by failure to specify the critical location of the laid-in-rubber rim the claim of the patent is invalid for failure to satisfy 35 U.S.C. § 112. The mandate for a particular and distinct claim of the subject matter constituting the invention was not satisfied. *Wilcox Manufacturing Co.* v. *Eastern Gas & Fuel Associates*, supra; *Triumph Hosiery Mills, Inc.* v. *Alamance Industries*, 299 F.2d 793 (4 Cir. 1962)."

In the above-quoted paragraphs the Court of Appeals not only requires that Claim 3 identify the *exact* location of the rim of the foot cover on the foot but also refuses to consider the drawings or to give full value to the patent specification in determining the scope of Claim 3. In both respects, the Court of Appeals erred to the detriment of petitioners' highly sucessful invention.

1. The Court of Appeals erred in holding that the specification and drawings of the patent in suit could not be referred to for the purpose of narrowing the claim and thus avoiding overclaiming.

The claim in suit reads as follows:

"3. A knitted *foot cover* comprising a seamless tubular rim including at least some rubber threads,

Said rim being adapted to form an opening for a foot entry,

a seamless tubular *body* having an axial length greater than that of said rim and connected with said rim,

said rim and said body, each, respectively, consisting

of the same knitting structure throughout its entire axial length and throughout its entire periphery and a seam formed at the end of said body opposite said rim, to form a *symmetrical pouch-like body,* and *said body being adapted to function as tip, sole and heel portions of said foot cover.*" (emphasis supplied)

The description of the specification reads in part as follows:

"It is an object of the invention to provide an improved method of manufacturing *undersocks or foot covers.* In one respect, methods of the invention are characterized in that a seamless tube is formed which consists of a continuous sequence of tubular elements each of which corresponds to an *undersock or foot cover and each of which consists essentially of a rim having an integrated* rubber thread and a body." (emphasis supplied)

* * * * *

"The upper rim of the product is very flat and has an excellent elasticity.

Illustrative embodiments of undersocks or foot covers made according to the invention will next be described and are diagrammatically illustrated in the accompanying drawing in which:"

* * * * *

"*FIG. 5 shows a foot cover forming an end product of the method of the invention.*

In the drawing, seamless tube 1 consists of periodically recurring hose elements each of which corresponds to one foot cover. *Each hose element consists essentially of three sections, namely a rim 2 a body 3 and a surplus course.*" (emphasis supplied)

* * * * *

"During the knitting of the rim 2, a rubber thread 5 is incorporated or inserted in the yarn by means of a conventional rubber feeding device as is known for hosiery machines. This rubber thread is inserted in the manner of a woven fabric (FIG. 4a) such that the rubber thread lies substantially along the periphery of the rim and transversely of the knitting direction. The rubber thread can be wound with the same tension as the other threads, so that when the tube is withdrawn from

the machine, the resilience of the rubber thread causes reduction in the diameter of the rim portion 2 as seen in FIG. 2. *Rim 2 in the illustrated embodiment has a length of about 1 cm.* At the translation from the rim 2 to the body 3, the rubber thread is ommitted and knitting of the hose is continued. *The length of this body depends on the material used and may be, for example, about 4-6 cms.*" (emphasis supplied)

* * * * *

"*The desired result thus can be achieved only with a very high stretchability and elasticity which insures at the same time a good hugging of the foot by the foot cover.*

FIG. 5 shows a foot cover in use." (emphasis supplied)

Figure 5 of the drawings in the patent is reproduced herewith:

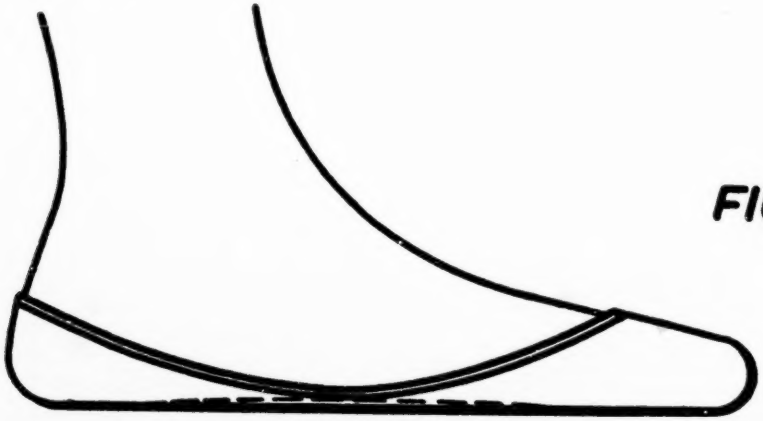

FIG. 5

Petitioners strongly contend that the Circuit Court, *on the basis of an issue that was never even presented to the trial court by the respondent* (respondent's charge of indefiniteness in the trial court was limited to Claim 3's use of the terms "knitting structure" and symmetrical"), improperly held that Claim 3 is invalid for overclaiming and for failure to comply with 35 U. S. C. § 112 through a misunderstanding of the wording of Claim 3 and through a further misunderstanding of the established principle of law which

would require that the Court interpret the language of Claim 3 in the light of the description in the specification and FIG. 5 of the drawings.

Claim 3 states at the outset that it relates to a "foot cover," thus establishing that the sock to which it relates is one which is adapted to cover the *foot* and not the ankle or leg. If the inventor had intended to claim a conventional sock to fit both the foot and leg or ankle, he would no doubt have referred to it as such. Claim 3 then refers to three elements, (1) the rim, (2) the body and (3) the seam, concluding with the statement that the body is adapted "to function as tip, sole and heel portions of said foot cover." The Circuit Court held that "while thi claim recites that the body does function as 'tip, sole and heel portions' of the foot cover, absent is any language to exclude the body from also covering part of the instep, the ankle or parts of the foot in the area below the ankle." Petitioners submit that the implication of the term "foot cover" and the reference to the body as covering the "tip, sole and heel portions of said foot cover' makes it clear that the inventor was claiming as his invention a structure which was located on the foot entirely below the ankle and below the instep in such a manner as not to be visible above the shoe top. For the Circuit Court to have held that the body of the sock might also have covered other portions of the foot or ankle was entirely unreasonable in view of the obvious intention of the draftsman of the claim to limit the claim to a below the shoe-top sock. If the claim had been intended to cover other portions of the foot, it would have made reference to those portions of the foot in the concluding phrase.

At the very least, the Court was placed under an obligation, if it had any difficulty in understanding the term "foot cover" and those portions of the foot which the foot cover was intended to encompass, to refer to the description of the specification and drawings in order to ascertain the meaning of the patentee's terminology. This it absolutely refused to do, holding cryptically that "the drawings cannot properly

be referred to for the purpose of narrowing the claim." AN EXAMINATION OF THE DESCRIPTION OF THE SPECIFICATION ABOVE QUOTED REVEALS THAT THE TERM "FOOT COVER" IS FREQUENTLY USED AS AN EQUIVALENT OF THE TERM "UNDERSOCK", CLEARLY A REFERENCE TO THE FACT THAT THE SOCK WAS DESIGNED TO BE WORN BELOW THE LEVEL OF THE SHOE TOP.

The specification also states that the "undersock or foot cover . . . consists essentially of a rim having an integrated rubber thread and a body." The description goes on to point out that the "rim in the illustrated embodiment has a length of about one cm." One cm. is equal to .39 of an inch. Thus the rim of the patented product is effectually described as being of such a length that, when connected with a body which covers the tip, sole and heel portions of the foot, it would not extend above that portion of the foot which is located within the shoe. This is particularly true when we consider that the rim of the patented product is only about one cm. in length even before its length is shortened by being stretched upon the foot. According to the description in the specification, the length of the body is *not* made dependent upon some such criterion as the length of the sock desired to be manufactured but rather upon "the material used," such length being characterized by the description as from four cms. to six cms., or the equivalent of from one and a half to two and one-third inches, again before the sock is stretched upon the foot. This again evidences (1) an assumption that the foot cover is designed to remain below the level of the shoe top and (2) a scope which limits the proportions of the sock of the invention to an UNDERSOCK which remains below the level of the shoe top.

Finally, the description states that "FIG. 5 shows a foot cover in use." FIG. 5 IS THE ONLY DRAWING IN THE PATENT WHICH DEMONSTRATES THE MANNER IN WHICH THE FOOT COVER OF CLAIM 3 IS LOCATED ON THE FOOT OF THE WEARER AND IT

CLEARLY SHOWS ALL PORTIONS OF THE FOOT COVER BELOW THE ANKLE AND BELOW THAT PORTION OF THE INSTEP WHICH WOULD PROTRUDE FROM A LOW-CUT SHOE. In stating that "Claim 3 gives no particularity as to the part or shape of the foot or leg portion the rim contracts against, or where it is located relative to the instep, the Circuit Court refused to interpret the claim in the light of the description of the specification and the drawings. In this highly arbitrary action, it clearly violated basic principles of law enunciated by this Court and by other Circuit Courts of Appeals.

In quoting § 112 of Title 35 of the United States Code in its footnote #6, the Circuit Court omitted the last paragraph of that section, which reads as follows:

> "An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

Thus the language of Claim 3, "said body being adapted to function as tip, sole and heel portions of said foot cover," is within the express authorization of the last paragraph of § 112.

In "Commentary on the New Patent Act" by P. J. Federico, Examiner in Chief of the Patent Office at the time of the hearings before congressional committees, 35 U.S.C.A. 1 at 25, Mr. Federico makes the following statement with regard to § 112:

> "The last paragraph of section 112 relating to so-called functional claims is new. It provides that an element of a claim for a combination (and a combination may be not only a combination of mechanical elements, but also a combination of substances in a composition claim, or steps in the process claim) may be expressed as a means or step for performing a specified function, without the recital of structure, material or acts in support thereof. *It is unquestionable that some measure of greater lib-*

erality in the use of functional expressions in combination claims is authorized than had been permitted by some court decisions, and that decisions such as that in Halliburton Oil Well Cementing Co. v. Walker, 67 S.Ct. 6, 329 U.S. 1, 91 L.Ed 3 (1946) are modified or rendered obsolete, but the exact limits of the enlargement remain to be determined." (emphasis supplied)

Petitioners submit that the Circuit Court misunderstood the meaning of the last paragraph of § 112, if indeed that Court discerned its relevance at all; and this Court should allow this petition in order to provide the federal courts with much needed guidance in interpreting the above-quoted language.

To hold, as did the Circuit Court, that Claim 3 is invalid as overclaimed was in effect to hold that the "prior art" had disclosed a foot cover or undersock in which a rim with laid-in rubber was located below the ankle on that portion of the foot, and especially that portion of the instep, which is disclosed by the specification and drawings as being covered by the patented product in suit. This plainly is not true. As recognized in both opinions below, the combination of elments claimed is new, albeit each individual element *per se* is old; and one such element, the laid-in rubber in the rim, performs a new function in the combination, *i.e.*, that of "holding in place a sock located below the ankle and entirely within the shoe." Appendix for Appellant 13. Thus by all accepted criteria, the Sarbo foot cover is entitled to protection under the patent law.

That the Circuit Court erred in not giving proper weight to the specification and drawings of the Sarbo patent is evident from a recent decision of this Court, *United States* v. *Adams*, 86 S.Ct. 708, 713, 383 U.S. 39, 48 (1966), in which certain claims of the Adams patent were challenged on the ground that they did not mention a water electrolyte in them and the essence of the invention was the use of water in making the battery of the invention operative. This Court said:

"It is true that Claims 1 and 10, supra, do not mention

a water electrolyte, but, as we have noted, a stated object of the invention was to provide a battery rendered serviceable by the mere addition of water. *While the claims of a patent limit the invention, and specification cannot be utilized to expand the patent monopoly,* Burns v. Meyer, 100 U.S. 671, 672, 25 L.Ed. 733 (1880); McCarty v. Lehigh Valley R.Co., 160 U.S. 110, 116, 16 S. Ct. 240, 242, 40 L.Ed. 358 (1895), *it is fundamental that claims are to be construed in the light of the specifiaction and both are to be read with a view to ascertaining the invention,* Seymour v. Osborne, 11 Wall. 516, 547, 20 L.Ed. 33 (1871); Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211, 312 U.S. 654, 61 S. Ct. 235, 85 L.Ed. 132 (1940); Schering Corp. v. Gilbert, 2 Cir., 153 F.2d 428 (1946). *Taken together with the stated object of disclosing a water-activated cell, the lack of reference to any electrolyte in Claims 1 and 10 indicates that water alone could be used.*" (emphasis supplied)

To paraphrase the *Adams* case, "taken together with the stated object of manufacturing a foot cover or undersock, which would necessarily be below the top of the shoe, the lack of reference to the exact location of the rim on the heel and instep of the foot in Claim 3 indicated that the rim was below the level of the shoe top." This conclusion is confirmed by the other language of the description and by FIG. 5 of the drawings.

In *Exhibit Supply Company* v. *Ace Patents Corporation,* 62 S.Ct. 513, 518, 315 U.S. 126, 135 (1942), in which this court was called upon to consider the meaning of the term "embedded" in a table as that term was used in a claim of the patent in suit there, this Court stated that "(T)he term is to be read as used in a permissible sense which would conform to the drawings and the function which the conductor to which the term was applied was obviously intended to perform."

The case of *Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 59 S.Ct. 8, 13, 305 U.S. 47, 59 (1938), which was relied upon by the Circuit Court as the basis for its holding that Claim 3 was invalid for overclaiming, far from supporting that

conclusion, actually contradicts it. In holding that the Gulick and Maynard patents in suit there were invalid for overclaiming and for failure to describe the invention as required by the predecessor to § 112, the Court said:

> "As already indicated, the omission from the specifications was not supplied by the drawings, which failed to disclose by dimension the proportions of the webs.
>
> * * * * *
>
> "So far as they [the lower courts] relied on the drawings to supply the omission they disregarded the facts shown both by the inspection and by the evidence presented here that the drawings do no more to point to Gulick's invention than does the fact of inherent flexibility.
>
> * * * * *
>
> "As flexible webs are neither described in Maynard's specifications nor mentioned in his claims, they can be imported into them only by reference to the drawings or by inference from the inherent flexibility of the structure, which, for reasons already given in our consideration of the Gulick amendments, are insufficient to accomplish that result."

In other words, this Court indicated in the *Schriber-Schroth Co.* case that it is appropriate to interpret the claims in the light of the drawings and specification, which the Circuit Court refused to do in the present case. If it had done so, the disclosure of the specification and drawings would have made it clear that the patent in suit does not overclaim.

Ther are a number of cases in which this Court, although holding patents invalid for overclaiming where their specifications and drawings did not provide the assistance necessary to determine the limited nature of the claims, has indicated that, especially when the language of the claim is such that resort to the specification and drawings may be helpful in interpreting it, the courts should look to such specification and drawings for help in construing the claim.

> See: *Graver Tank & Manufacturing Co.* v. *Linde Air Products Co.*, 69 S.Ct. 535, 539, 336 U.S. 271, 277 (1949)

("While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention. When they do so to the point of their invalidity *and are free from ambiguity which might justify resort to the specifications,* we agree with the District Court that they are not to be saved because the latter are less inclusive.") (emphasis supplied)

Permutit Co. v. *Graver Corporation,* 52 S.Ct. 53, 55, 284 U.S. 52, 60 (1931) (Moreover, *while drawings may be referred to for illustration and may be used as an aid in interpreting the specification or claim,* they are of no avail where there is an entire absence of description of the alleged invention, or a failure to claim it. . . . *The free bed was neither described in the specification nor claimed in either Claim 1 or Claim 5.")* (emphasis supplied)

Halliburton Oil Wells Cementing Co. v. *Walker,* 67 S.Ct. 6, 11, 329 U.S. 1, 11 (1946) ("Neither in the specification, the drawing, nor in the claims here under consideration, was there any indication that the patentee contemplated any specific structural alternative for the acoustical resonator or for the resonator's relationship to the other parts of the machine.")

Other federal courts have recently followed the principle as enunciated by this Court. For example, in *Yosemite Chemical Co.* v. *United States,* 149 U.S.P.Q. 635, 639 (Court of Claims 1966), the Court of Claims, in upholding a patent, the validity of which was challenged on the ground that the patentee had overclaimed, said:

"Defendant urges also that the patent claims are inoperative due to overclaiming, in that they are so broad and generic in nature as to encompass a variety of chemical compounds that would not serve the function of the invention.

* * * * *

Broad statements of the law to the effect that a patent must describe the invention with a great degree of precision must be read in light of the cricumstances of each individual case. *Georgia-Pacific Corp.* v. *U. S.*

Plywood Corp., 258 F.2d. 124, 118 U.S.P.Q. 122 (2d Cir. 1958), cert. denied 358 U.S. 884, 119 U.S.P.Q. 501 (1958). The relevant patent statutes require that the claims be adequately described to indicate their true content and scope, but the disclosure called for need not be greater than that which is reasonable under the circumstances, having due regard to the nature of subject matter involved. *In re Hudson*, 205 F.2d 174, 40 C.C.P.A. 1036, 98 U.S.P.Q. 151 (1953). *The inventor is not to be deprived of the fruits of his labor by too technical a requirement of disclosure, and it is adequate for purposes of validity if his claims are sufficiently clear and exact to be understandable by those skilled in the relevant art. Lever Bros. Co.* v. *Proctor & Gamble Mfg. Co.*, 139 F.2d 633, 60 U.S.P.Q. 76 (4th Cir. 1943); *Hazeltine Research, Inc.* v. *Dage Elec. Co., Inc.*, 271 F.2d 218, 122 U.S.P.Q. 180 (7th Cir. 1949); *Research Prod. Co.* v. *Tretolite Co.*, 106 F.2d 530, 43 U.S.P.Q. 99 (9th Cir. 1939). In the present suit the evidence as a whole fails to corroborate defendant's assertion, based upon the *Chesterfield* case, supra, that substantial experimentation would have to be undertaken to determine which compounds fa' ng within the literal range of the claims would be effective for use in the removal process. * * * *Moreover, the patent specification assists those who would practice the invention by identifying certain chemical compositions that do in fact work.* See *Union Oil Co. of Calif.* v. *American Butumuls Co., supra.* Thus, although it can be said that the general te.m "fatty acid or organic soap of a divalent metal" may technically encompass certain inoperative species, the claims, by themselves, *or as read in light of the specification,* may be readily comprehended by those skilled in the art, do not cover inoperative species, and would pose no particular problems in application." (emphasis supplied)

* * *

Thus, the Fourth Circuit's holding in the principal case is in direct conflict with the Court of Claims.

Patentees are generally allowed much latitude in terminology and the language that they use will be given the meaning which is intended by them if it can be ascertained

from the context. This principle, that it is appropriate in determining the limits of the patent to consult the drawings and specification, has been adopted by many other circuits and is frequently referred to as "axiomatic." For example, in *Lincoln Stores* v. *Nashua Mfg. Co.*, 157 F.2d 154, 158 (1st Cir. 1946), cert. denied 67 S.Ct. 623, 329 U.S. 811 (1947), the United States Court of Appeals for the First Circuit, in upholding certain patent claims made the following statement:

> "The defendant challenges claim 7 of the Amory patent as not meeting the standards of clarity required by R.S. § 4888, 35 U.S.C.A. § 33, because it is impossible to determine whether a given blanket infringes the patent. This challenge is based on the defendant's assertion that the word 'staple' as used in the claim has no exact meaning. * * * The district court held, however, that the word 'staple' as commonly used in the rayon industry and as used in this patent, means a filament cut to a predetermined length and that *this definition read in the light of the specifications requires that the filling wrapping contain fibers of a predetermined length, preferably 1" to 2"*, and it concluded that there was no difficulty in deciding which blankets infringe and which do not. We agree with the district court.
>
> *Patentees are allowed much latitude in terminology and the language they use will be given the meaning intended by them if it can be ascertained from the context. Strong-Scott Mfg. Co.* v. *Weller*, 8 Cir. 1940, 112 F.2d 389, 394. *It is immaterial that we must refer to the specications for an understanding that the fibers are to be cut to a length of between 1" to 2". Skinner Bros. Belting Co.* v. *Oil Wells Improvements Co.*, 10 Cir. 1931, 54 F.2d 896, 899." (emphasis supplied)

In *Wyott Manufacturing Co.* v. *Doran Coffee Roasting Co.*, 160 F. Supp. 644, 648, (D. Col. 1958) mod. on other grounds 267 F.2d 200 (10th Cir. 1959), a Colorado District Court upheld patent claims against the charge of indistinctiveness in the following language:

> "The final affirmative defense is that the Titus patent was invalid for indistinctiveness. Here it is asserted

> that the claims disclose a patent ambiguity by describing the leg bottom variously as "concave" and "convex from the under side." However, the leg bottom was *illustrated in a similar manner in each of the illustrations, and these drawings may be referred to in order to construe any ambiguity in the claims. Permo, Inc.* v. *Hudson-Ross, Inc.*, 7 Cir., 1950, 179 F.2d 386; *Chicago Forging & Mfg. Co.* v. *Bade-Cummings Mfg. Co.*, 6 Cir., 1933, 63 F.2d 928. See also, Walker on Patents, Deller's Ed. Sec. 262. Taken together, there could be no real doubt as to what was meant by the description, and any mechanic skilled in the art could have constructed the device from the description in the claims and specification. *Where this is so, the patent will not fail for ambiguity, although more accurate language could perhaps have been used.* 35 U.S.C.A. § 112." (emphasis supplied)

In *Winget Kickernick Co.* v. *Kenilworth Mfg. Co.*, 11 F.2d 1, 2 (2nd Cir. 1926), the Second Circuit Court upheld patent claims against a charge of indistinctiveness as follows:

> The appellant argues that there is nothing in these claims which clearly advance the characteristics of a front member and of a back member, but *the court may look at the specifications and drawings to determine the characteristics and meaning of the elements recited in the claim. The language does not mean any kind of front member, or any kind of back member, but it is that kind of member, front or back, which is shown and described in combination with the other elements recited in the claims.* This describes the principle of construction and the invention to be protected." (emphasis supplied)

Moreover, contrary to the position taken by the Circuit Court in the principal case, other federal courts have specifically held that the drawings accompanying the specification may be referred to in order to ascertain the true meaning of the terms used in describing the invention and have limited claims by the structures which appeared in the drawings.

See:

Krauth v. *Autographic Register Company*, 285 F. 199,

206, (D.C.N.J. 1921) revd. on other grounds, 286 F. 240. ("While the specification and claims are silent as to the particular shape of the pins, if it be considered necessary that this should be made known, attention is called to the fact that the drawings, in connection with which the claims and specification must be construed, disclose their shape.");

Waterloo Cement Machinery Corp. v. *Engle*, 240 F. 976, 978, (2nd Cir. 1917) ("It is not essential that the claim shall describe in detail each element of the combination; it is enough if these details are shown in the description and drawings.");

Steiner and Voegtly Hardware Co. v. *Tabor Sash Co.*, 178 F. 831, 836 (C.C.N.J. 1910) ("The drawings accompanying the specification and referred to in the descriptive parts thereof will be examined to ascertain the true meaning of the terms used in describing the invention.")

The effect of the Circuit Court's refusal to give due weight to the specification and drawings in the principal case in construing Claim 3 is to violate the principle enunciated in its own earlier decisions. In *Black and Decker Mfg. Co.* v. *Baltimore Truck Tire Service Corp.*, 40 F.2d 910, 914 (4th Cir. 1930), in reversing a holding of invalidity by the lower court, the 4th Circuit said:

"It is said that the fifty claim is too broad and is anticipated by the Witherell patent. We do not think so. * * * Furthermore, *it is elementary that the language of the claims is to be construed in the light of the description and drawings. Hogg* v. *Emerson*, 11 How. 587, 13 L.Ed. 824; *Wicke* v. *Ostrum, supra*, 103 (C.C.A. 7th) 215 F. 586. And, when so construed, there can be no question that the language used refers to a device for ascertaining the wheel load on motor vehicles and not to such devices as that covered by the Witherell patent. *While it is true that courts will not ordinarily interpret a positively recited generic expression as limited to the precise instrumentality disclosed by the patent, they will do even this where such narrow interpretation is necessary to distinguish the claim from the prior art*

> *and uphold the validity of the claim.*" (emphasis supplied)

Plainly, the term "foot cover" is a term which the court should have treated as relating by the custom of the trade to a sock which is concealed beneath the level of the shoe top, or else a term which required the court to consult the specification and drawings for further definition. By refusing to consult the drawings and specification to see that the claims referred to an UNDERSOCK and thus did not include the prior art, the court disregarded its own precedents as well as those of this Court and other federal courts.

Judge Learned Hand phrased this principle as follows in *Bragg-Kliesrath Corp.* v. *Walter S. Vogel & Co.*, 67 F.2d 531, 532 (2nd Cir. 1933):

> "Patent claims are peculiar in that in a proper case courts will save them by limiting their expressed intent to so much of the field as the prior art leaves open; this is the converse of the doctrine of equivalents."

In applying the doctrine of equivalents and thus relieving persons charged with patent infringement of liability, federal Circuit Courts of Appeals have very recently reiterated the principle that any ambiguity in claims is to be resolved in the light of the specification and drawings in order to limit such claims. For example, in *Illinois Tool Work, Inc.* v. *Brunsing*, 156 U.S.P.Q. 610, 611 (9th Cir. 1968), the 9th Circuit made the following statement:

> "As the findings of fact indicate, the trial court construed the patent claims in light of the specification and drawings. This was appropriate procedure, *the rule being that the specification and drawings must be looked to in order to properly grasp the invention or explain any ambiguity in the claims.* It is also to be borne in mind that the specification may not be used to enlarge a claim, but *can be used to limit the claim.*" (emphasis supplied)

See also *DelFrancia* v. *Stanthony Corporation*, 278 F.2d 745, 747 (9th Cir. 1960); rehearing denied 1960;

Victor Cooler Door Co. v. *Jamison Cold Storage Door*

> *Co.*, 44 F.2d 288, 291 (4th Cir. 1930) (It is elementary that the language of the claims is to be construed in the light of the specification and drawings . . . *In view of the state of the prior art, to which we shall hereafter refer, the claim must be held limited to this particular device in order that the validity of the patent may be upheld.*") (emphasis supplied)

The Fourth Circuit Court's reliance upon the case of *Binks Mfg. Co.* v. *Ransburg Electro-Coating Corp.*, 281 F. 2d 252 (7th Cir. 1960) in supporting the principle that drawings cannot properly be referred to for the purpose of narrowing the claim was ill-placed. There the Seventh Circuit Court held that the principle enunciated in the claims was broader than that of the drawings and that the claims were nonetheless *valid* in a form which read upon the defendant's infringing device. There is certainly nothing inconsistent with this principle of equvalents and the principle for which the petitioners are contending in the case at hand. Indeed, the *Binks* court specifically held that the invention in that case was *not* overclaimed and cited the third paragraph of § 112 to support the right of the patentee to express an element of his claim in terms of a specified function rather than a structure, when the structure is included in the specification.

Likewise, the case of *Wilcox Mfg.* v. *Eastern Gas and Fuel Associates,* 400 F.2d 960 (D.C.W.Va. 1967) which was cited by the Circuit Court to support the same proposition, is not apposite. There the plaintiff patentee sought to broaden the scope of its patent claim in order to cover the defendant's device charged to infringe, rather than seeking to limit such claims; and there was nothing in the specification and drawings to support such *broader* scope.

Similarly, the cases which were cited by the respondent in its brief in the Circuit Court, *application of Custer,* 173 F.2d 226 (C.C.P.A. 1949) *in re Laurent* 186 F.2d 741 (C.C.P.A. 1951) and *application of Edwards,* 285 F.2d 811 (C.C.P.A. 1961), are all distinguishable from the principle case in that those cases the language of the claims in issue

was self-sufficiently broad and therefore there was no occasion to read that language in the light of the specification and drawings. In the case at bar, on the other hand the term "foot cover" is typical of terminology as to which the Court will consult the specification and drawings in order to determine its meaning as an UNDERSOCK.

2. The Court of Appeals erred by imposing too rigorous a test of particularity in holding that 35 U.S.C. § 112 requires the claim in suit to specify the particular loca- of the laid-in rubber rim on the foot of the wearer.

Much of what petitioners have already said in connection with the previous discussion of the Circuit Court's error in refusing to interpret Claim 3 in the light of the specfication and drawings is also applicable here. The effect of its holding of invalidity was to compound the same grievous error by also refusing to consult the specification and drawings in testing the patent by the requirements of 35 U.S.C. 112, which calls for particularity in the claims with respect to the subject matter constituting the invention.

Reference to the specification and drawings makes it clear that the invention claimed relates to a sock which is concealed beneath the level of the shoe top. There was no necessity for the patentee to define the location of the laid-in rubber rim any more definitely than that. Indeed, in footnote #5 of the opinion of the Court of Appeals, the Court of Appeals itself suggested that the petitioner might have articulated his invention by adopting language similar to that of the Herbert U. S. Patents which recite, "A slipper type foot covering of such height as to be completely concealed from view when worn within an outer pump or other such lower cut shoe. . . ." By reference to the specification and drawings for the definition of the term "foot cover" and the structure included within the meaning of the last phrase of Claim 3, the Court of Appeals would easily have ascertained that Sarbo was claiming his invention in just the type of sock which is concealed below the level of the shoe.

In *Georgia-Pacific* v. *United States Plywood Corp.*, 258 F.2d 124, 135 (2nd Cir. 1958), cert. denied 358 U.S. 884 (1958), Judge Lumbard restated the basic principles with respect to the precision required in order to satisfy the provisions of section 112 as follows:

> *"It has often been stated that the scope of claims should be limited in light of the specifications if necessary to uphold the patent,* see e.g. *Westinghouse Electric & Mfg. Co.* v. *Quackenbush*, 6 Cir., 1931, 53 F.2d 632, 634, 1111. *The rule applies only if the claims are ambiguous . . .*
>
> We think that the district court was too rigorous in applying the requirement of precision. *This requirement serves two primary purposes: those skilled in the art must be able to understand and apply the teachings of the invention and enterprise and experimentation must not be discouraged by the creation of an area of uncertainty as to the scope of the invention. On the other hand, the policy of the patent statute contemplates granting protection to valid inventions, and this policy would be defeated if protection were to be accorded only to those patents which were capable of precise definition.* The judicial function requires a balancing of these competing considerations in the individual case.
>
> It is true that the Supreme Court has stated that "(a)n invention must be capable of accurate definition, and it must be accurately defined, to be patentable," *United Carbon Co.* v. *Binney & Smith Co.*, 1942, 317 U.S. 228, 237, 63 S.Ct. 165, 170, 87 L.Ed. 323, and this Court recently stated that "* * * the requirement of the Act for definiteness in the statement of claims must be strictly construed,; Helene Curtis Industries, Inc. v. Sales Affiliates, supra, 233 F.2d at page 160. Such general statements, however, must be viewed in the context of circumstances. *Objectionable indefiniteness must be determined by the facts in each case, not by reference to an abstract rule. Chicago Pneumatic Tool Co.* v. *Hughes Tool Co.*, 10 Cir., 1938, 97 F.2d 945, 948 certiorari denied 305 U.S. 643, 59 S.Ct. 146, 83 L.Ed. 415. ** * * If the claims, read in the light of the specifications, reasonably apprise those skilled in the art both of the*

utilization and scope of the invention, and if the language is as precise as the subject matter permits, the courts can demand no more. See *Lever Bros. Co.* v. *Proctor & Gamble Mfg. Co.*, 4 Cir., 1943, 139 F.2d 633, 639; *H. H. Robertson Co.* v. *Klaur Mfg. Co.*, 8 Cir., 1938, 98 F.2d 150, 153. That an area of uncertainty necessarily exists in such a situation cannot be denied, but the existence of an inescapable area of uncertainty is not sufficient justification for denying to the patentee the fruits of his invention.

Indeed, in the administration of the patent statutes uncertainty has been introduced by express judicial creation. It has often been stated that the scope of the patent is limited by the language of the claims. Where, however, an infringer has attempted to appropriate the essence of the invention while remaining outside the language of the claims, courts have not hesitated to apply the doctrine of equivalents, whereby the 'essence' of the invention is protected. See *Claude Neon Lights* v. *E. Machlett & Son.*, 2 Cir., 1929, 36 F.2d. 574, certiorari denied 281 U.S. 741, 50 S. Ct. 347, 74 L.Ed 1155. In such situations the patentee is protected even though he has been more precise than the subject matter of the invention permits or requires. *It would be anomalous if this Court were to strike down a patent created by the language of the specifications and claims rather than by judicial application of equivalency doctrine.*

* * * * *

"This inevitable imprecision, however, is not fatal, *Claim 1, read, as it must be, in the light of the specifications and drawings* [*H. H. Robertson Co.* v. *Klauer Mfg. Co., supra; Chicago Pneumatic Tool of Newton, Mass.* v. *Coe*, 1938, 68 App. D.C. 255, 96 F.2d 527] *reasonably indicates to the industry the teachings and the the scope of the patent. . . . Although the two drawings of the patent are concededly diagrammatic rather than to scale, they convey a visual perspective which aids in the interpretation of the claim.*

* * * * *

"Here both the specification and the claim to some extent interrelate a description of configuration and function, but we think the latter merely aids in understanding the scope of the patent. The patentee is not

> *attempting to claim a function, stress relief, and all the manifold ways of obtaining it, thus claiming more than his invention.''* (emphasis supplied)

Under the test enunciated in the *Georgia-Pacific* case, it is enough that the claim as read in the light of the specification and drawings enables a person skilled in the art to make and use the invention and limits the scope of the invention.

It is clear that the respondent Russell Hosiery Mills was able to understand the Sarbo patent sufficiently to make and use the invention of the petitioners in the principal case, as the respondent admits having copied petitioners' sock. The sock which he copied is essentially the one which is illustrated in FIG. 5 of the patent and described in the specification. It is also clear that Sarbo's Claim 3, as interpreted in the light of the specification and drawings, shows that the laid-in rubber rim of the sock, as well as the remaining portions of the sock, were concealed below the level of the shoe, thus limiting the scope of the patent.

The same principle has been recently enunciated by the United States Court of Appeals for the 3rd Circuit in *Jones Knitting Corp.* v. *Morgan*, 361 F.2d 451, 453 (3rd Cir. 1966), rehg. den. 1966. There in upholding patent claims against a charge of invalidity for failure to satisfy the requirements of § 112, the Court made the following statement:

> ''Regardless of the fact that the term ''heat-insulating'' may be one of degree, there is abundant evidence on this record taken as a whole that when one skilled in the art reads the Moragn Patent, he would be capable of producing the patented fabric and of determining the limits of the patent. As we interpret the statutory standard, this is all the inventor need show. 35 U.S.C.A. § 112.
>
> * * * * *
>
> ''These references suffice for us to state, in summary, our conviction that the evidence shows that the patent teaches with sufficient conciseness how the invention might be put into use and also gives sufficient warning to the would-be infringer of the patent's limits. *The*

fact that the patent also uses a term capable of only relative definition is not fatal.'' (emphasis supplied)

See also: *Corning Glass Works* v. *Anchor Hocking Glass Corp.* 374 F.2d 473, 477 (3rd Cir. 1967)

The 6th Circuit has recently made it clear that it subscribes to the same principle. In *Tilotson Mfg. Co.* v. *Textron, Inc., Homelite,* 337 F.2d 833, 840 (6th Cir. 1964), against the charge that the patent in suit in that case was invalid for failure to satisfy § 112, the Court held that the patent was sufficiently definite and made the following further statement:

> ''Appellant relies on 35 U.S.C. § 112 (1952).
> There is noting vague or confusing about this claim to a person skilled in the carburetor art. *It must be interpreted in the light of the specification and drawings.* The test is whether the disclosures make the invention clear to a mechanic skilled in the art so that he could construct the carburetor and use it. *Schriber-Schroth Co.* v. *Cleveland Trust Co.,* 311 U.S. 211, 61 S.Ct. 235, 85 L.Ed. 132 (1940).
> *Whether the patent properly describes the invention so as to enable any person skilled in the art to make and use it must be determined by consideration of the specification, drawings, claims and the other evidence in the case.''*
>
> * * * * *
>
> ''Nor do we believe that the location of the diaphragm in the carburetor requires experimentation of the type condemned by the patent law. *A specific example of the carburetor was given in the specification. The fact that some testing may be required in calibrating carburetors for different engines does not render the claims indefinit where adequate guideposts were furnished as here.''* (emphasis supplied)

See also:

Hawkinson Co. v. *Wilcoxen,* 149 F.2d 471, 475 (6th Cir. 1945);
H. H. Robertson Co. v. *Klauer Mfg. Co.,* 98 F.2d 150, 153 (8th Cir. 1938);
Chicago Pneumatic Tool Co. v. *Hughes Tool Co.,* 97

F.2d 945, 948 (10th Cir. 1938); cert. denied 305 U.S. 643, 59 S.Ct. 146;
Ideal Roller & Mfg. Co. v. *Sutherland Paper Co.*, 96 F.2d 675, 677 (6th Cir. 1938).

Thus it is clear that most of the other federal Circuit Courts have adopted the view that § 112 was not intended to deprive Sarbo of the right to have his specification and drawings referred to for the purpose of determining the meaning of words such as "foot cover" in the claim, but rather that it was intended to continue such principle in force, and indeed to liberalize it, in the sense of expressly authorizing the statement of one of the elements in functional terms. In departing from this principle, the Fourth Circuit has invited the attention of this Court to resolving the conflict.

CONCLUSION

For the reasons set forth in this petition we respectfully submit that certiorari should be granted.

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APPENDIX A

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 12,054

WAYNE KNITTING MILLS AND
THE MAY CORPORATION, Appellees
versus
RUSSELL HOSIERY MILLS, INC., Appellant

Appeal from the United States District Court for the Middle District of North Carolina, at Rockingham.

EUGENE A. GORDON, *District Judge.*

(Argued April 2, 1968 Decided September 10, 1968)

Before SOBELOFF, BOREMAN and WINTER,
Circuit Judges.

Thomas B. Van Poole (Charles R. Fenwick, and Mason, Fenwick & Lawrence; Welch Jordan, and Jordan, Wright, Henson & Nichols on brief) for Appellant, and David H. Semmes and Joseph W. Grier, Jr. (Charles B. Park, III, on brief) for Appellees.

WINTER, *Circuit Judge:*

Before us for determination are the questions of the validity of Claim 3 of Sarbo United States Patent No.

3,059,458, issued October 23, 1962, and whether certain of defendant's hosiery products infringe. The patent concerns knitted foot covers designed to be worn as a liner in shoes of various styles instead of stockings or conventional socks. The district court declared Claim 3 of the patent valid and infringed.[1] *For failure to distinguish the prior art—and hence for overclaiming—and for failure to comply with 35 U.S.C. §112 we find the patent invalid, and reverse.*

The claim in suit reads:

> "3. A knitted foot cover comprising a seamless tubular rim including at least some rubber threads,
> said rim being adapted to form an opening for a foot entry,
> a seamless tubular body having an axial length greater than that of said rim and connected with said rim,
> said rim and said body, each, respectively, consisting of the same knitting structure throughout its entire axial length and throughout its entire periphery and
> a seam formed at the end of said body opposite said rim, to form a symmetrical pouch-like body, and
> said body being adapted to function as tip, sole and heel portions of said foot cover."

"Foot cover" is not defined in the specifications; neither is it defined in the claim, except as a definition may be inferred from the language employed. A drawing (Figure 5) accompanying the specifications depicts "a foot cover forming an end product of the method of the invention," as one of several "[I]llustrative embodiments of undersocks or foot covers made according to the invention," and the drawing shows a foot cover on a human foot with the rim at all places below the ankle, barely covering the toes, partially covering the heel and between them dipping almost to the sole. The claim, the specifications and the drawing are not otherwise specific as to the degree of coverage of any part of the foot below the ankle.

[1] 274 F. S. 934 (M.D. N.C. 1967). The district court also reserved the fixing of damages, if any, for infringement, and denied attorney's fees and dismissed the action as to an individual defendant. No appeal from these rulings has been taken. In pretrial proceedings, plaintiffs withdrew any claim for unfair competition.

The patent was the result of the activities of Edgar G. Sarbo in Vienna, Austria, which culminated in 1958. Prior to then, shoe-top-length foot socks adapted for wear with low cut shoes were available in at least two forms: (a) a type, known as "Peds" and "Footlets" made from flat knitted fabric cut from such fabric and sewn into the desired shape with a sewn-in elastic rim around the foot entry opening, and (b) a sock, such as previously manufactured by defendant, which was knitted as a conventional sock with a very short top and with reciprocatorily knitted heel and toe pockets (a time-consuming process), the knitted fabric being then cut down at the top and instep and provided with a sewn-in elastic rim around the foot entry opening. These known types were comparatively expensive to manufacture because of the labor required for cutting and sewing and because of the time required for reciprocatory knitting. Additionally, they were uncomfortable because the heavy band or rim of elastic around the foot opening tended to burrow into the foot of the wearer as a result of pressure from the shoe.

Sarbo, a manufacturer of conventional socks, became aware of the deficiencies of available shoe-top-length foot socks as a result of a customer's inquiry. Sarbo's mill did not engage in cutting and sewing operations. Ultimately, he developed a shoe-top-length sock which could be produced entirely by knitting and without need for cutting or sewing. On November 19, 1958, Sarbo filed for letters patent in Austria. On November 13, 1959, Sarbo filed a corresponding patent application in the United States,[2] which matured into the patent in suit.[3] Plaintiff, Wayne Knitting Mills, Inc., is

[2] By the Convention of the Union of Paris of March 20, 1883, ratified by the United States as of May 30, 1887, Sarbo, as a foreign resident, who sought a United States patent within one year after his Austrian filing, is afforded the benefit of his patent application filing date in his home country.

[3] In addition to Austria and the United States, Sarbo also was granted letters patent by Argentina, Belgium, Canada, Denmark, Finland, France, Germany, Great Britain, Greece, Italy, Luxemburg, Norway, Spain, Sweden and Switzerland. In addition to the United States, Sarbo has licensed his patent rights in Germany, Spain and Switzerland.

the ultimate assignee of the Sarbo patent.

Unaware of the Sarbo development, plaintiff, The May Corporation, principally through its Charlie T. Smith, an employee of May's research and development department, began work on an improved shoe-top-length sock in 1949. A ten-year interruption then ensued because May was busily occupied in national defense work. In 1959, Smith resumed his efforts and, by 1962, he developed the "extended gore sock." This style, however, did not fit low enough on the foot for wear with slipper-type shoes, and it required reciprocatory knitting to shape it. Smith's efforts continued and, in 1963, independently and without knowledge of Sarbo's patent, Smith hit upon the Sarbo concept.

When May began to manufacture the Smith sock, it was confronted with the Sarbo patent by Sarbo's then licensee. May then purchased the Sarbo patent. From September, 1963, to the date of trial, May had manufactured and sold over 5,300,000 pairs of Sarbo socks and thus had captured a significant segment of the prior shoe-top-length sock market.

In 1964, defendant, after seeing a Sarbo sock, began the manufacture of one of its styles of socks accused of infringement. After formal notice of infringement, defendant introduced two other styles, one which has never been commercially produced, and the other which is also accused of infringement.

The patent is a combination patent. Concededly, each of the elements of the combination was well known in the industry and had been disclosed in patents predating Sarbo.[4]

[4] For example: (a) knitted foot covers made from symmetrically knit straight seamless tubes were disclosed by 1923 Teichmann British Patent No. 184,470; 1922 Teichmann German Patent No. 362,040; 1923 Teichmann Swiss Patent No. 102,524; 1929 Teichmann U. S. Patent No. 1,724,784; 1932 Bellak U. S. Patent No. 1,841,518; 1944 Grey U. S. Patent No. 2,333,373; 1944 Herbert U. S. Patent No. 2,344,773, and 1946 Herbert U.S. Patent No. 2,400,692; (b) fabrication of the top or rim of tubular foot covers to cause them to hug or cling to the foot was taught by Teichmann British (a cord or lacing device), Bellak U. S. (plain stitch or laced-in elastic), and Grey U. S. and Herbert U. S. (knitted welts or double thickness fabric); (c) 1941 St. Pierre U. S. Patent No. 2,246,079 taught the use of laid-in rubber threads in the rims of various seamless circular knit socks and stockings.

Plaintiffs, nevertheless, claim that in combination, laid-in-rubber in the rim of the Sarbo sock performs a new function, i.e., the rubber threads serve to conform the rim of the below-shoe-top-length sock to the irregular configuration of the foot (as opposed to *the circular configuration* of the leg or ankle) and hold the body of the sock in tensioned condition below the instep and on the toe, sole and heel of the foot. This function, so the argument runs, is different from the function of rubber-top in above-the-shoe socks wherein the rubber-top exerts an inward force in the cylindrical leg to prevent the top from sliding down, or in below-the-ankle socks, when the rim is below the ankle but still around the cylindrical leg to prevent the rim from sliding down. Essentially adopting this argument, the district judge remarked that "[T]here is no evidence that laid-in rubber or elastic yarn previously served the function of holding in place a sock located below the ankle and entirely within the shoe." (274 F. S. at 940.) The district judge's ultimate conclusion was expressed:

> "It is apparent that those skilled in the art, probably due to the irregular configuration of the foot as compared with the uniform configuration of the ankle and leg members, could not accept or grasp the idea that rubber or elastic yarn could be laid in with proper tension to keep a below the ankle length sock on the foot. * * * The combination of Claim 3 of the patent in suit teaches a new and useful result, that is, the old elements could be joined to make a shoe-top-length sock that would stay up on the irregular contours of the foot and could be comparatively cheaply manufactured." (274 F. S. at 941).

From plaintiffs' argument and the district judge's conclusion, it is apparent that the lower location where the laid-in rubber rim serves its function is critical to the validity of Sarbo Claim 3, both as to inobviousness and new function. Yet, the exact location of the rim is not identified anywhere in the claim. At most, the claim implies a location below the ankle, but plaintiffs and the court below predicate the valid-

ity of the claim, not on the entire area below the ankle, but on the undetermined location below the ankle where the ankle ceases to resemble the cylindrical conformation of the leg and exhibits the irregular configuration of the foot.[5] Specifically, Sarbo Claim 3 gives no particularity as to the part or shape of the foot or leg portion the rim contracts against, or where it is located relative to the instep. While this claim recites that the body does function as "tip, sole and heel portions" of the foot cover, absent is any language to exclude the body from also covering part of the instep, the ankle or parts of the foot in the area below the ankle.

Lacking language disclosing how the patented device should be constructed so as to position the elasticized rim below the ankle in the place where it can perform its theretofore undiscovered—and hence new and novel—function, the claim, in our view, is invalid, because it is so broad that it claims as invention that which plantiffs concede was not new. Stated otherwise, by the breadth of the claim that which is conceded to have been known in the prior art—that which the prior art anticipated or made obvious—is included within the claimed invention; hence, the clam is invalid for overclaiming. *Schriber-Sibroth Co.* v. *Cleveland Trust Co.*, 305 U. S. 47 (1938). See also, *Heyl & Patterson, Incorporated* v. *McDowell Company*, 317 F.2d 719 (4 Cir. 1963). And the drawings cannot properly be referred to for the purpose of narrowing the claim. *Binks Mfg. Co.* v. *Ransburg Electro-Coating Corp.*, 281 F.2d 252, 256 (7 Cir. 1960). *Cf. Wilcox Manufacturing Co.* v. *Eastern Gas & Fuel Associates*, 400 F.2d 960 (4 Cir., Decided Sept., 1968).

It follows, also, that by failure to specify the critical location of the laid-in-rubber rim the claim of the patent is in-

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[5] Should Sarbo or his counsel have had difficulty in articulating more narrowly what he conceived to be his invention, they might have sought guidance from 1944 and 1946 Herbert U. S. Patents Nos. 2,344,773 and 2,400,692 which recite "A slipper type foot covering of such height as to be completely concealed from view when worn within an outer pump or other such lower cut shoe * * *."

valid for failure to satisfy 35 U.S.C. § 112.[6] The mandate for a particular and distinct claim of the subject matter constituting the invention was not satisfied. *Wilcox Manufacturing Co.* v. *Eastern Gas & Fuel Associates*, 400 F.2d 960:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*" (emphasis supplied)
>
> * * * * *

supra; Triumph Hosiery Mills, Inc. v. *Alamance Industries*, 299 F.2d 793 (4 Cir. 1962.)[7]

REVERSED.

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[6] In pertinent part, the statute reads:
"§ 112. Specification

[7] As pointed out in *Corning Glass Works* v. *Anchor Hocking Glass Corp.*, 374 F.2d 473, 477 (3 Cir. 1967) "Section 112, 35 U.S.C.A. is designed to protect the patentee and encourage experimentation in the area not covered by the patent." In the *Triumph Hosiery Mills* case, we said, in regard to a patent which overclaimed and which we held violated, *inter alia*, § 112:

"The uncertainties and confusion arising from such a patent would be intolerable. Infringement would be difficult to judge, for just when the patentees' manufacture was within or without the patent would not be readily apparent to a competitor. The patent would seem to embrace a therapeutic unplied monofilament torque nylon stocking with a compression even below the minimum pressures givn in some of the claims and in the first table of the specifications. For a surety, it encompasses without ceiling all of this type of stocking having a compressiveness above these measurements. The result would be to discourage a competitor, through fear of suit, to put on the market any such stocking with a plurality of ends, whatever its compression. A vast and unwarranted field is thus usurped by the patent.

"This expanse of monopoly, with the *interrorem* effect upon competitors already mentioned, does not 'promote the Progress of Science and useful Arts'." 299 F.2d 793.

APPENDIX B

IN THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

Appeal No. 12,054

WAYNE KNITTING MILLS AND
THE MAY CORPORATION, Plaintiffs-Appellees

vs.

RUSSELL HOSIERY MILLS, INC., Defendant-Appellant

JUDGMENT

Appeal from the United States District Court for the Middle District of North Carolina.

THIS CAUSE came on to be heard on the record from the United States District Court for the Middle District of North Carolina at Rockingham and was argued by counsel.

ON CONSIDERATION WHEREOF, It is now here ordered and adjudged by this Court that the Judgment of the said District Court appealed from, in this cause, be, and the same is hereby remanded to the United States District Court for the Middle District of North Carolina of Rockinham, for further proceedings consistent with the opinion of this Court filed herein.

September 10, 1968

s/Samuel W. Phillips, Clerk

APPENDIX C

Oct. 23, 1962 E. G. SARBO 3,059,458

FOOT COVE. AND METHOD OF MANUFACTURING THE SAME

Filed Nov. 12, 1959 2 Sheets-Sheet 1

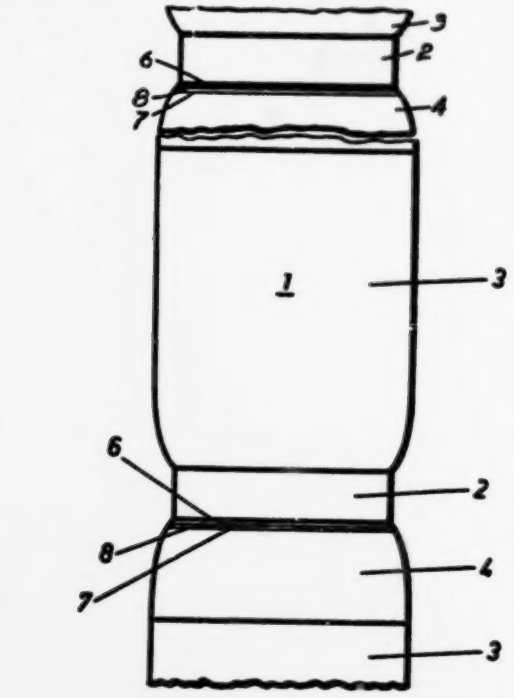

FIG. 1

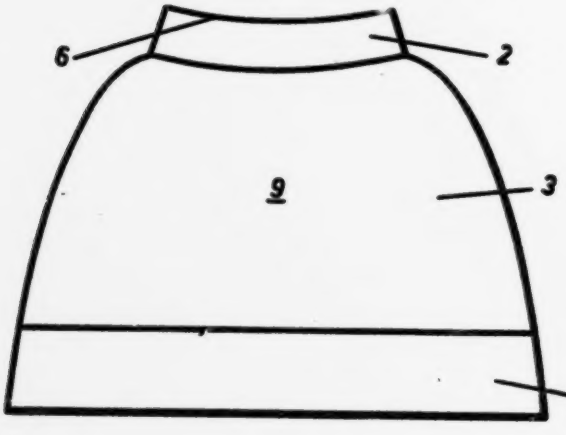

FIG. 2

Oct. 23, 1962 E. G. SARBO 3,059,458

FOOT COVER AND METHOD OF MANUFACTURING THE SAME

Filed Nov. 12, 1959 2 Sheets-Sheet 2

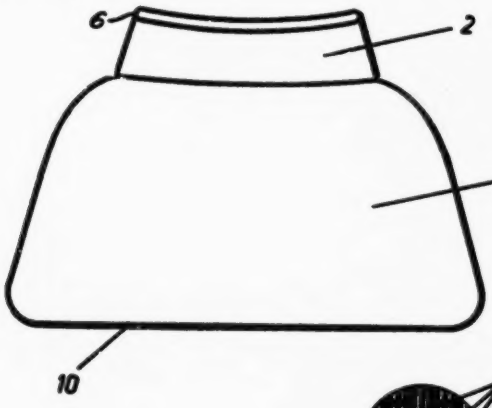

FIG. 3

FIG. 4a

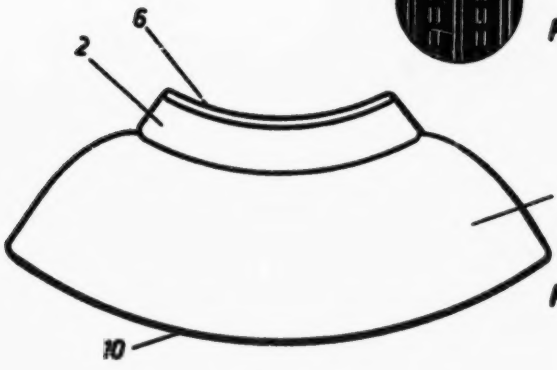

FIG. 4

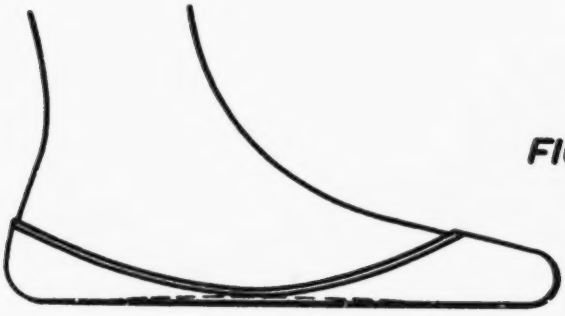

FIG. 5

United States Patent Office
3,059,458

Patented Oct. 23, 1962

3,059,458

FOOT COVER AND METHOD OF MANUFACTURING THE SAME

Edgar Gary Sarbo, Vienna, Austria, assignor to Bruder Sarbo, Vienna, Austria

Filed Nov. 12, 1959, Ser. No. 852,442
Claims priority, application Austria Nov. 19, 1958
3 claims. (Cl. 66—171)

This invention relates to undersocks or foot covers and to methods of manufacturing the same.

Undersocks or foot covers are conventionally made from woven fabric blanks and sometimes from knitted semi-finished products of composite constructions which have a number of seams whereby, for example, the front top part of the foot cover is connected to the base thereof and the latter is joined at its rear edge. Known methods of manufacture thus involve certain surplus steps and cost particularly for sewing, and the finished article generally has pronounced seams and requires sewn-in rubber elements in the form of a tape.

It is an object of the invention to provide an improved method of manufacturing undersocks or foot covers. In one respect, methods of the invention are characterized in that a seamless tube is formed which consists of a continuous sequence of tubular elements each of which corresponds to an undersock or foot cover and each of which consists essentially of a rim having an integrated rubber thread and a body. Surplus courses followed by separating courses are

interposed between the individual tube elements so that the individual tube elements can be separated, the courses being concatenated and then closed off or hemmed so that each foot cover is finished at its lower end by a seam of relatively high stretchability.

Such undersocks or foot covers may be manufactured most advantageously by the use of mass production techniques at relatively low cost. They have no seam other than the highly stretchable almost imperceptible seam indicated above. The upper rim of the product is very flat and has an excellent elasticity.

Illustrative embodiments of undersocks or foot covers made according to the invention will next be described and are diagrammatically illustrated in the accompanying drawing in which:

FIG. 1 shows a portion of a continuous seamless hose including elements of an article of manufacture provided in accordance with the invention;

FIG. 2 illustrates a semi-finished foot cover;

FIGS. 3 and 4 each show a finished foot cover;

FIG. 4*a* illustrates a detail in enlarged scale; and

FIG. 5 shows a foot cover forming an end product of the method of the invention.

In the drawing, seamless tube **1** consists of periodically recurring hose elements each of which corresponds to one foot cover. Each hose element consists essentially of three sections, namely a rim **2**, a body **3** and a surplus course **4**. The seamless tube **1** may be made on a conventional machine and suitable for this purpose woud be, for example, a single-roller, double-roller or circular knitting machine the operation of which requires only a special setting of a conventional control drum or the like. During the knitting of the rim **2**, a rubber thread **5** is incorporated or inserted in the yarn by means of a conventional rubber feeding device as is known for hosiery machines. This rubber thread is inserted in the manner of a woven fabric (FIG. 4*a*) such that the rubber thread lies substantially along the periphery of

the rim and transversely of the knitting direction. The rubber thread can be wound with the same tension as the other threads, so that when the tube is withdrawn from the machine, the resilience of the rubber thread causes reduction in the diameter of the rim portion **2** as seen in FIG. 2. Rim **2** in the illustrated embodiment has a length of about 1 cm. At the transition from the rim **2** to the body **3**, the rubber thread is omitted and knitting of the hose is continued. The length of this body depends on the material used and may be, for example, about 4-6 cms. After the body **3** has been formed in the desired length, the knitting yarn for the foot cover is suitably replaced by a cheaper yarn with which the knitting is continued, for example, for about 2 centimeters to form surplus courses **4**. These surplus courses **4** are followed by separating courses **7** (and, if desired, break threads **8**) to define the limit of an individual hose element which will be subsequently used to make a foot cover. This is followed by the starting edge for a new element.

The seamless tube **1**, which is collected, for example, in a container, may comprise any desired number of hose elements and is removed from the machine after a predetermined number of hose elements such as, perhaps, one hundred, have been completed. Then the hose elements can be manually separated from the seamless tube to obtain the semi-finished foot covers **9**, one of which is shown in FIG. 2. The separation is effected by cutting the hose at the separating courses and pulling out the separating thread. The top part of the foot cover terminated with the starting rim **6** is now finished. Next the semi-finished foot cover **9** must be closed at its lower end spaced from the rim **2**. For this reason it is cast onto needles at the surplus courses **4** on a circular or flat linking machine of known type. This machine suitably cuts off the surplus courses **4**, brushes off the cut surface and closes off the course applied to said needles. By this seam **10** (closing seam, machine seam or the like), the foot cover is finished at its lower end and assumes a form which is pocket or bag-like.

The material for the parts 2 and 3 of the hose elements may consist of stretch yarn, crimped yarn, or cotton or wool yarn and the like. FIG 3 shows the shape of a foot cover made from cotton whereas FIG. 4 shows a foot cover made from crimped yarn. Mixed crimped and ply yarns or any other known combination of yarns may be used. The use of crimped yarn has the advantage that the foot cover can be manufactured in uniform size for all foot sizes. Since the surplus courses 4 are cut off, they are preferably made from cheap material such as cotton.

The seamless hose is conventionally knitted so as to be extremely elastic and extensible because the diameter of the tube 1 is preferably matched to that of the lower calf of the leg whereas the end product, which is the finished foot cover, must accommodate the size of the foot. The desired result thus can be achieved only with a very high stretchability and elasticity which insures at the same time a good hugging of the foot by the foot cover.

FIG. 5 shows a foot cover in use. The rubber threads 5 incorporated in the rim 2 avoid local constriction as would result from the use of a rubber tape. This is favored by the fact that the rim of the foot cover according to the invention in relatively wide without being thick. The single seam 10 integrates with the knit courses and does not protrude when the foot cover is worn. It is also highly stretchable as is particularly important in the use of the cover and the stretchability of the foot cover is not adversely affected by this seam.

Compared to the foot covers made according to known processes, the foot covers made by the method of the invention can be manufactured efficiently and at low cost. Further, they insure a good fit with a soft, resilient pressure. Owing to the method of manufacture from a seamless hose, as has been described hereinbefore, they completely avoid irritating the foot.

What is claimed is:

1. A method of manufacturing a plurality of foot covers

consisting of a continuous sequence of tubular hose elements, comprising the steps of

knitting continuously a seamless tubular hose,
forming alternately during said knitting step three distinct symmetrical portions, first, a rim including rubber threads, second, a body and third, surplus courses between the end of said body and the start of the next rim, each of said three distinct portions, respectively, being of the same knitting structure throughout its entire length and throughout its entire periphery,
cutting of said surplus courses, and
forming a stretchable seam at the end of said body opposite said rim entirely across said tubular hose.

2. A knitted tubular hose for the manufacture of a plurality of foot covers, including
a seamless tube comprised alternately of a rim and of a body of greater axial length than said rim,
said rim including at least some rubber threads,
said rim and said body, each, respectively, consisting of the same knitting structure throughout its axial length and throughout its entire periphery, and
a surplus course disposed between said rim and the body adjacent thereto, a transverse seam formed at the end of said body opposite said rim and a break thread disposed between said rim and the surplus course adjacent thereto.

3. A knitted foot cover comprising
a seamless tubular rim including at least some rubber threads,
said rim being adapted to form an opening for a foot entry,
a seamless tubular body having an axial length greater than that of said rim and connected with said rim,
said rim and said body, each, respectively, consisting of the same knitting structure throughout its entire axial length and throughout its entire periphery, and
a seam formed at the end of said body opposite said rim,
to form a symmetrical pouch-like body, and
said body being adapted to function as tip, sole and heel portions of said foot cover.

References Cited in the file of this patent

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2,035,384	Hinchliff	Mar. 24, 1936
2,246,079	St. Pierre	June 17, 1941
2,333,373	Grey	Nov. 2, 1943
2,739,467	Stern	Mar. 27, 1956
2,881,603	Vendetti	Apr. 14, 1959
2,896,339	Rabinowitz	July 28, 1959

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NO. 806

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

WAYNE KNITTING MILLS AND THE MAY CORPORATION,
Petitioners

VS.

RUSSELL HOSIERY MILLS, INC., *Respondent*

PETITIONERS' SUPPLEMENTAL APPENDIX D

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NO. 806

IN THE

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OCTOBER TERM, 1963

WAYNE KNITTING MILLS AND THE MAY CORPORATION,
Petitioners

VS.

RUSSELL HOSIERY MILLS, INC., *Respondent*

PETITIONERS' SUPPLEMENTAL APPENDIX D

IN THE UNITED STATES DISTRICT COURT
FOR THE MIDDLE DISTRICT OF NORTH CAROLINA
ROCKINGHAM DIVISION

(Received October 19, 1967)

Civil Action No. C-183-R-65

WAYNE KNITTING MILLS and THE MAY CORPORATION,
Plaintiffs,

v.

RUSSELL HOSIERY MILLS, INC., and PAUL RUSSELL, President,
Defendants.

Judgment

This civil action came on to be tried before the Court, sitting without a jury, and the Court having considered the evidence introduced by the parties and the briefs and arguments of counsel, and the Court having made its findings of fact and conclusions of law as set out in a Memorandum Opinion dated and filed herein on September 29, 1967:

IT IS, THEREFORE, ORDERED, ADJUDGED AND DECREED as follows:

(1) That the Court has jurisdiction of the parties and the subject matter of this civil action.

(2) That the plaintiff Wayne Knitting Mills is the sole and exclusive owner of U. S. Letters Patent No. 3,059,458 granted October 23, 1962, to Edgar G. Sarbo.

(3) That Claim 3 of said U. S. Letters Patent No. 3,059,458 is good and valid in law.

(4) That the defendant Russell Hosiery Mills, Inc., has infringed Claim 3 of said U. S. Letters Patent No. 3,059,458 by the manufacture and sale of its Styles 1334 A and 1334 C foot covers.

(5) That the plaintiffs shall have and recover of the defendant Russell Hosiery Mills, Inc., the damages which the plaintiffs have sustained by reason of the aforesaid infringements by the defendant Russell Hosiery Mills, Inc.

(6) That the defendants have not knowingly and deliberately infringed Claim 3 of said Letters Patent, but have diligently and honestly sought to avoid infringements, and the plaintiffs' prayer for treble or increased damages is denied.

(7) That no exceptional circumstances are found in this case and, therefore, the plaintiffs' prayer for attorneys' fees is denied.

(8) That the defendant Paul Russell is not liable to the plaintiffs or either of them, and as to him the complaint is dismissed.

(9) That the defendant Russell Hosiery Mills, Inc., its agents and servants, and all persons in active concert or participation with them, be and they are hereby restrained and enjoined, directly or indirectly, from manufacturing, using or selling Styles 1334 A and 1334 C foot covers or any other knitted shoe-top-length foot covers embodying the invention claimed in Claim 3 of said Letters Patent.

(10) That the plaintiffs recover of the defendant Russell Hosiery Mills, Inc., the taxable costs of the plaintiffs and such costs and expenses as may be incurred in connection with an accounting of the damages recoverable by the plaintiffs, and the defendant Paul Russell recover of the plaintiffs the taxable costs of said defendant in this suit.

(11) That this judgment is final except for accounting and is appealable.

EUGENE A. GORDON
United States District Judge

Dated: October 18, 1967,
at Winston-Salem,
North Carolina

(Received September 29, 1967)

Memorandum Opinion

GORDON, District Judge

This is an action for infringement of Claim 3 of the Sarbo patent (United States Letters Patent No. 3,059,458, issued October 23, 1962) relating to knitted shoe-top-length foot covers or socks. The plaintiffs initially alleged both patent infringement and unfair competition against the corporate defendant. After discovery ensued, the unfair competition charge was withdrawn. The action is now solely for patent infringement against the defendant, Russell Hosiery Mills, Inc., and against the defendant, Paul Russell, President of Russell Hosiery Mills, Inc., for actively inducing others to infringe the Sarbo patent by manufacturing and selling shoe-top-length foot covers.

The product which is the subject of the patent in suit is a knitted article of ladies footwear designed to be worn on the foot without showing above the top of the shoe, to give the "bare-legged" look when worn, as it customarily is, without conventional socks or hosiery. Footwear of this type has been called footcovers, shoe-top-length foot socks, footees, liners, peds, and footlets.

It is contended by the defendants that Claim 3 of the Sarbo patent is invalid for lack of invention; for want of invention over the state of the prior art as described in patents and publications before the Sarbo invention or discovery or granted or published more than one year prior to the filing date of the application for the Sarbo patent; for want of adequate and sufficient disclosure in the specification and drawings thereof; and because Claim 3 is vague and indefinite and inherently incapable of particularly pointing out and distinctly claiming an invention over the prior art as required by 35 U.S.C. § 112. In the alternative, even if Claim 3 is determined to be valid, the defendants deny that they infringed the claim.

Claims 1 and 2 of the patent are not alleged to have been infringed, and only the footcovers produced by the defendant, Russell Hosiery Mills, Inc., under the designation Style 1334 A and Style 1334 C are alleged to infringe Claim 3 of the Sarbo patent

The case was heard on the issues of validity, infringement, and inducement of infringement by the individual defendant. The issue of damages was deferred.

Having now carefully considered all of counsels' proposals, arguments, and contentions, as well as the testimony, pleadings, stipulations, briefs, and exhibits submitted, and the reasonable inferences to be drawn therefrom, the Court pursuant to Rule 52 of the Federal Rules of Civil Procedure makes its Findings of Fact and Conclusions of Law as follows:

Findings of Fact

1. Plaintiff, Wayne Knitting Mills, a corporation, is the owner of the U. S. Letters Patent No. 3,059,458, granted October 23, 1962, to Edgar G. Sarbo, a United States citizen, who resided in Vienna, Austria, on October 23, 1962. Plaintiff, Wayne Knitting Mills, became the owner of the Sarbo patent through various assignments, and is actively engaged in the manufacture of shoe-top-length footcovers.

2. Until about July 5, 1965, plaintiff, The May Corporation, was known as May Hosiery Mills. On or about July 5, 1965, plaintiff, Wayne Knitting Mills, acquired all of the assets of May Hosiery Mills, including the patent in suit, and the name of May Hosiery Mills was changed to The May Corporation.

3. The Sarbo patent was issued on an application having an actual filing date of November 12, 1959, and an effective filing date, under the International Convention, of November 19, 1958. The patent in suit, No. 3,059,458, named Edgar G. Sarbo, of Vienna, Austria, as the inventor

and while the application was pending in the U. S. Patent Office the patent rights were assigned by Edgar G. Sarbo to Bruder Sarbo, also of Vienna, Austria. On or about December 3, 1964, the patent was assigned by Bruder Sarbo to Renfro Hosiery Mills Company, a North Carolina corporation, and on or about January 26, 1965, was assigned by Renfro to May Hosiery Mills pursuant to an agreement of December 22, 1964. The patent was then assigned by May Hosiery Mills to the plaintiff, Wayne Knitting Mills, on July 3, 1965.

4. Prior to Sarbo's method and product in 1958, shoe-top-length foot socks were available in the market but were made either from flat knitted fabric,[1] which was then cut and sewn into the desired shape and provided with a sewn-in elastic rim around the foot entry opening or knitted as a regular sock, having reciprocated heel and toe pockets which would then be cut down at the top and provided with a sewn-in elastic rim around the foot entry opening. The defendant, Russell Hosiery Mills, Inc., was making a cut and sewn shoe-top-length sock at the time it began making the Sarbo type sock in July, 1964. These shoe-top-length foot socks were not only comparatively expensive to manufacture due to the fact that cutting and sewing had to be performed but also were rather uncomfortable by reason of the fact that they were provided with a heavy band or rim of elastic sewn around the foot opening which tended to burrow into the foot of the wearer due to the pressure of the shoe. Cutting and sewing is a time consuming operation requiring skilled operators and entailing considerable waste.

5. The sock of the Sarbo invention is a symmetrical pouch-like sock which is reversible from heel to toe. It is made from a seamless stretch tube of knitted fabric closed across the bottom with a stretchable seam and pro-

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[1] As distinguished from tubular seamless fabric as in the Sarbo sock.

vided with some rubber threads in the top to form an elastic rim. The courses of the Sarbo sock run longitudinally of the foot rather than transversely of the foot as is the case with a conventional hosiery product. In summary, the finished product consists simply of a short length of circular knit, seamless, tubular fabric, similar to that employed in making the top and upper leg portion of seamless hosiery, having several courses of rubber laid in at what is to become the top of the foot cover, followed by a number of courses of plain knit fabric, both of which are knitted on conventional, circular knitting machines in a manner similar to conventional knitting of seamless hosiery. In practice, the sock of the Sarbo invention is knitted of stretch yarn, so as to have the capacity to stretch about a wide variety of foot sizes and conform to the lower portion of the foot which normally lies within the shoe.[2]

6. The only claim of the Sarbo patent charged to be infringed is Claim 3, which is directed to the ultimate foot cover product.[3] This claim is directed to a combination of elements forming a knitted foot cover. The sock of the Sarbo invention can be made on practically any type of circular hosiery machine and can be closed along the bottom by a conventional looping operation or seamed with a straight machine seam by relatively unskilled personnel.

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[2] The evidence shows that the Sarbo sock is often worn within extremely low cut shoes such as ladies' high heel slippers.

[3] Claim 3 is as follows:

"3. A knitted foot cover comprising a seamless tubular rim including at least some rubber threads, said rim being adapted to form an opening for a foot entry, a seamless tubular body having an axial length greater than that of said rim and connected with said rim, said rim and said body, each, respectively, consisting of the same knitting structure throughout its entire axial length and throughout its entire periphery, and a seam formed at the end of said body opposite said rim, to form a symmetrical pouch-like body, and said body being adapted to function as tip, sole and heel portions of said foot cover."

The sock does not require boarding or other shaping operation prior to marketing.

7. Sarbo began manufacturing and selling his shoe-top-length sock of the type described in the Sarbo patent in Austria and on November 19, 1958, filed an application for patent in Austria. On November 12, 1959, Sarbo filed a corresponding application in the United States which eventually matured into the patent in suit, issued October 23, 1962. Having filed his application for a patent in the United States pursuant to the provisions of an International Agreement,[4] the Sarbo United States Patent is entitled to the benefit of the November 19, 1958, application filing date, which date is the date that the application for patent was filed in Austria.

8. In addition to obtaining patents on the shoe-top-length foot socks in Austria and the United States, Sarbo also obtained patents on the socks in Argentina, Belgium, Canada, Denmark, Finland, France, Germany, Great Britian, Greece, Italy, Luxemburg, Norway, Spain, Sweden, and Switzerland, and has licensed his patent rights in Germany, Spain, and Switzerland.

9. As early as 1959, and without any knowledge of the Sarbo patent or of any foot socks made thereunder, the plaintiff, The May Corporation, then known as May Hosiery Mills, sought to improve the objectionable features of their shoe-top-length foot socks then on the market. The employee of May Hosiery Mills charged with the responsibility for developing the sock was C. T. Smith. Smith's instructions were to develop a circular knit shoe-top-length foot sock which would not require cutting and sewing and in which it would not be necessary to use a sewn-in rubber band to hold it up. Smith did develop a sock containing an

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[4] Convention of the Union of Paris of March 20, 1883, for the protection of industrial property, ratified by the United States as of May 30, 1887.

extended gore requiring some reciprocatory knitting to shape the sock. Circular knit fabrics having reciprocated heel and/or toe pockets are much more expensive to produce, as compared with the Sarbo type, by reason of the extra time consumed in the knitting. The sock thus developed by Smith did not fit low enough on the foot to give the "bare legged" effect. Nevertheless, on August 11, 1964, U. S. Patent No. 3,143,870 was issued to May on this Smith development.

10. After the development of the extended gore sock, Smith continued to work toward an improved shoe-top-length sock, still without any knowledge of the Sarbo patent or of any footcovers made thereunder, and in approximately August of 1963 Smith hit upon the same combination as the Sarbo patent. On October 4, 1963, the plaintiff May filed an application in the United States Patent Office incorporating the Sarbo concept and started manufacturing and selling foot socks of the Sarbo type. The May application was rejected by the U. S. Patent Office on May 16, 1966, as unpatentable in view of the French Patent to Sarbo (which patent corresponds to the patent in suit), the Grey U. S. Patent (No. 2,333,373 issued November 2, 1943), and the Friedrich German Patent (No. 841,131 issued November 4, 1952).

11. Defendant, Russell Hosiery Mills, Inc., began knitting style 1334 A in October, 1964, and ceased to knit style 1334 A in January, 1965. Defendant's style 1334 B was never commercially produced. In March, 1965, the defendant began knitting its style 1334 C.

12. The Court additional makes those "Findings of Fact" which appear in the "Discussion" which follows.

Discussion

Lack of Invention

Broadly stated, the principal issue in this case is whether Claim 3 of the Sarbo patent[5] is shown to be obvious or known to persons skilled in the art from patents already existing prior to the Sarbo invention or by the knowledge and practices existing in the hosiery industry prior to invention.[6]

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[5] Claim 3 is directed to a combination of elements to form a knitted foot sock, without reciprocal knitting, from a piece of seamless circular knit tubular fabric rather than from cut and sewn flat fabrics or from circular knit fabrics involving reciprocation.

[6] 35 U.S.C.A. § 102 provides in part:

"§ 102. *Conditions for patentability; novelty and loss of right to patent*

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or . . ."

35 U.S.C.A. § 103 provides:

"§ 103. *Conditions for patentability; non-obvious subject matter*

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made. July 19, 1952, c. 950, § 1, 66 Stat. 798.

The plaintiffs contend that the Sarbo patent relates to a new combination of known elements, the combining of which would not have been obvious at the time it was done. It is admitted by the plaintiffs that seamless knitted tubes, incorporation of rubber threads in knitted fabrics and the sewing of seams transversely across the lower end of a piece of tubular fabric were all old and known in the art prior to the Sarbo concept in 1958, leading to issuance of the patent in suit.

Thus, since admittedly all elements of Claim 3 are old, it becomes the duty of the Court to scrutinize the claim under the exacting standards established where inventiveness is claimed in an assembly of old elements. *Great Atlantic & Pacific Tea Co.* v. *Super Market Equipment Corp.*, 340 U.S. 147, 152, 71 S. Ct. 127, 95 L. Ed. 162, 167 (1950); *Heyl and Patterson, Inc.* v. *McDowell Co., Inc.*, 4 Cir., 317 F. 2d 719, 722 (1963).

The improbability of finding invention in a combination patent is a recognized premise in many cases, but where the combination of old and known elements "perform or produce a new, different or additional function or operation in the combination than that theretofore performed or produced by them" patentability has been recognized. *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equipment Corp., supra; Entron of Maryland, Inc.* v. *Jerrold Electronics Corp.*, 4 Cir., 295 F. 2d 670 (1961).

In *City of Grafton* v. *Otis Elevator Co.*, 4 Cir., 166 F. 2d 816, 817 (1948), Judge Dobie, writing for the court, sets out some requisites for a valid combination patent:

> "We are dealing here with a combination patent. The requisites for a valid combination elaborate citation of authorities, in 40 Am. Jur. 543, § 19: 'A combination is a composition of elements, some of which may be old and others new, or all old or all new. It is, however, the combination that is the invention, and is as much a unit in contemplation of law as a single

or noncomposite instrument. The authorities establish the following propositions respecting the patentability of devices or processes of this character: (1) that a combination is patentable if it produces new and useful results, although all its constituents were well known and in common use before it was made, provided the results are a product of the combination, and not a mere aggregate of several results, each the product of one of the combined elements; (2) if it produces a different force, effect, or result in the combined forces or processes from that given by their separate parts, and a new result is given by their union; (3) if it either forms a new machine of distinct character or formation, or produces a result which is not the mere aggregate of separate contributions, but is due to the joint and co-operating action of all the elements; (4) when the several elements of which it is composed produce by their joint action either a new and useful result, or an old result in a cheaper or otherwise more advantageous way.' "

To be patentable, the product or process must not only be a new and useful improvement over the prior art but also must not be obvious to one of ordinary skill in the particular art.

The evidence is convincing that the Sarbo sock was an improvement over the prior related socks. But to say an improvement is made is not to say patentable invention is present, because there must be the creation of something which did not exist before, possessing elements of novelty and utility in kind and measure different and exceeding that which the art might expect from those skilled in the art.

The defendants contend that Claim 3 of the patent in suit is clearly invalid because each and every one of the elements is old and functions in exactly the same way that it always functioned. Long before 1958, the circular knit-

ting machine was used to knit a tubular fabric to extend around and cover the leg member of the wearer. The seaming or looping opposite the end for the foot entry had been the customary way to close the foot end of a sock long prior to the Sarbo concept. The incorporation of rubber thread in the upper rim portion was known and used in hosiery manufacture for years prior to the Sarbo concept. The defendants argue that none of these elements in combination perform any function not previously served by them.

However, the question is not simply that of whether the old elements contained in the combination each performs its old function, but whether the elements making up the new combination produce a new, different or additional function or operation than that previously produced. There is no evidence that laid-in rubber or elastic yarn previously served the function of holding in place a sock located below the ankle and entirely within the shoe.

The "obviousness test" prescribed by 35 U.S.C. § 103 is difficult of application, but some guides have been given. It is to be remembered that in applying the test in the subject case the crucial date is 1958, the year the invention was made. Judge Learned Hand in *Reiner* v. *I. Leon Co.*, 2 Cir., 285 F. 2d 501, 503, 504 (1960) expressed some general guides to be followed in applying the test of whether the subject matter of a patent would have been obvious to one of ordinary skill in the art at the time of the claimed invention. He stated:

> "The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person 'having ordinary skill' in an 'art' with which we are totally unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the general history of the means available at the time. To judge on our own that this or that new assemblage of

> old factors was, or was not, 'obvious' is to substitute our own ignorance for the acquaintance with the subject of those who were familiar with it. There are indeed some sign posts: e.g. how long did the need exist; how many tried to find the way; how long did the surrounding and accessory arts disclose the means; how immediately was the invention recognized as an answer by those who used the new variant?'' *Reiner* v. *I. Leon Co.*, 2 Cir., 1960, 285 F. 2d 501, 503, 504.''

In the *Entron* case, *supra*, Judge Sobeloff writing for the court, after quoting the above language from the opinion written by Judge Hand in the *Entron* case, states that ''these general principles have, for many years, guided the decisions of this Circuit.'' Also, see *Marston* v. *J. C. Penney Co.*, 4 Cir., 353 F. 2d 976, 982 (1965).

The demand and need for the Sarbo-type sock is confirmed by the fact that the plaintiffs since commencing manufacture and sale of the sock in 1963 have sold in excess of $5,000,000 pairs. This figure does not take into consideration market consumption of the Sarbo-type sock manufactured by the defendant, Russell Hosiery Mills, Inc. The evidence discloses phenomenal success in marketing the Sarbo sock immediately after manufacturing was begun by the plaintiffs.

Further, it is evidence that the need had been recognized in the industry for many years prior to 1958. Indeed to fulfill the need the plaintiffs had its employee, C. T. Smith, as early as 1958, working to perfect a Sarbo-type sock, which he did perfect, without knowledge of Sarbo's prior invention, some four years later in 1963. The prior art socks were expensive to manufacture in that cutting and sewing were time consuming, required skilled operators, and the sewn-in rubber rim was uncomfortable and irritable to the foot.

In the subject case the unobviousness of the plaintiffs' combination is shown by the failure of the defendant

Russell Hosiery Mills, Inc., admittedly a strong contender in the manufacture of shoe-top or ankle length foot socks, to develop the Sarbo type sock. Mr. Earl A. Connelly, Executive Vice President of Russell Hosiery Mills, Inc., charged according to his testimony with responsibility for developing new products, testified that he saw the Sarbo sock in June or July, 1964; that when he saw it he was not impressed with it, but that after commercial production was started by Russell Hosiery Mills, Inc., in about October, 1964, he changed his mind. Mr. Connelly is a college graduate, with a Bachelor of Science Degree, and with a long and varied experience in hosiery development. While the test of obviousness should not and cannot be determined by one man skilled in the art, such as Mr. Connelly, it is significant that the Sarbo combination was not obvious to Mr. Connelly. Neither was it obvious to Mr. C. T. Smith, plaintiff's technician in charge of development, as it took some years to arrive at the Sarbo concept. Both Mr. Connelly and Mr. Smith had for years had experience with circular knitting whereby a tubular fabric was knit. Also, both had experience with looping or seaming of socks at the foot end and laying in rubber or elastic threads with a knitting machine at the top of the sock to hold it up.

Much prior to 1956, the provision of rubber or elastic yarn in the top part of hosiery to hold them up was well known. It was a common practice to use such yarn in knee-length hosiery, anklets and crew socks. It is apparent that those skilled in the art, probably due to the irregular configuration of the foot as compared with the uniform configuration of the ankle and leg members, could not accept or grasp the idea that rubber or elastic yarn could be laid in with proper tension to keep a below the ankle length sock on the foot. In fact, Mr. Connelly testified that in knitting the Sarbo-type sock at Russell Hosiery Mills, Inc., trouble was incurred with it "from the standpoint of it popping off at the back of the heel." The combination of Claim 3 of the patent in suit teaches a new and useful result, that is, the old elements could be joined to make a

shoe-top-length sock that would stay up on the irregular contours of the foot and could be comparatively cheaply manufactured.

The combination in the subject patent cannot rightly be compared with that described in *Great Atlantic & Pacific Tea Co., supra,* where the combination consisted of the mere elongation of a merchant's counter with a three-sided apparatus, with no floor, affixed to the counter in guides to pull groceries forward to the checking clerk.

Prior Patents

The defendants have cited in excess of twenty patents in support of their contention that the Sarbo patent is invalid. Primarily the defendants have relied upon the disclosures in the following patents as showing anticipation or lack of invention:

Teichmann British Patent No. 184,470, issued March 8, 1923

Teichmann Swiss Patent No. 102,524, issued December 1, 1923

Teichmann German Patent No. 362,040, issued October 21, 1922

Teichmann U. S. Patent No. 1,724,784, issued August 13, 1929

St. Pierre U. S. Patent No. 2,246,079, issued June 17, 1941

Grey U. S. Patent No. 2,333,373, issued November 2, 1944

Herbert U. S. Patent No. 2,344,773, issued March 21, 1944

Herbert U. S. Patent No. 2,400,692, issued May 21, 1946 and

Vendetti U. S. Patent No. 2,881,603, issued April 14, 1959.

Actually, each of the individual elements of Claim 3 of the patent in suit is disclosed in one or more of the patents cited by the defendants. Nevertheless, the Court finds that in none of the prior patents cited was there disclosed the combination revealed by Claim 3 of the patent in suit, and that the combination disclosed by Claim 3 produced a new and useful result not previously disclosed.

The defendants place much emphasis upon the Teichmann patents, especially the Teichmann British Patent No. 184,470, issued March 8, 1923. In the opinion of the Court, one must indulge in speculation to conclude that Claim 3 of the patent in suit was anticipated by the claims of Teichmann. While Patent Office drawings are not to be relied upon for details,[7] it is of note that Figure 2 of the British Teichmann shows supposedly tubular barrel shape fabric. Even now, there is not a commercial machine that will knit a barrel shape tubular fabric. A fabric can be knitted as a flat fabric and then cut and sewn into barrel shape. All the while, the Teichmann patents were available to the Patent Office. Neither of the Teichmann patents was cited in the Sarbo patent, but the Grey patent was cited in the Sarbo patent, and the Grey patent issued in 1942 cited both the United States and Swiss Teichmann patents. In reading the British Teichmann patent, and looking at the drawings, it could be surmised that the sock described was made to be worn below shoe top level, but the patent does not state that a sock designed to be worn completely within the confines of the shoe is claimed. In fact, using the cord or lacing device described would reasonably preclude its use as a beneath the shoe sock. In any event, the Teichmann patents apparently did not teach or make obvious the product which is the subject of the patent in suit as it is apparent that more than forty years after Teichmann, and long after circular knitting, rubber yarn and looping

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[7] *Toledo Scale Co.* v. *Barnes Scale Co.*, 18 F. 2d 965 (E.D. Mich. 1927).

or seaming were known, those in the industry were trying to resolve the problem.

The Swiss Teichmann and German Teichmann patents are similar to the British Teichmann except no express provision is made for a cord or lacing device and contrary to the British Teichmann specifically states that the fabric is knitted. The U. S. Teichmann discloses a foot garment but of the cut and sewn type.

St. Pierre U. S. patent and Vendetti U. S. patent were cited in the Sarbo application and disclose the use of elastic yarn in knitted socks, but do not relate its use to socks designed for wear entirely within the confines of the shoe.

Grey U. S. patent was cited in the Sarbo file wrapper. It discloses a shoe-top-length foot sock of seamless tubular knit fabric, closed across the bottom with a curved seam. The top of the garment is provided with a welt instead of elastic. The Grey sock is boarded to give it the desired shape and it is concluded could not be reversed so as to wear the toe-portion at the heel. Also, by reason of the curved seam, there must be some cutting and sewing to make the stock.

The Herbert U. S. patents disclose a circular knit shoe-top-length foot sock. However, the sock is shaped in the toe portion by cutting and sewing.

Elements of the Sarbo patent can be found in the patents cited, but the Court cannot find that the prior art completely anticipates and makes obvious the patent in suit.

Indefiniteness of Claim 3

Claim 3 of the patent in suit provides for a foot cover with "the same knitting structure throughout." It is contended by the defendants that this provision is indefinite

and violative of the requirement of particularity and distinctiveness in claims.[8]

To be patentable, an invention must be capable of accurate definition and particularly defined. This requirement is complied with only when what existed in the art before is distinguished from what is claimed and it is made clear that which is foreclosed from future use. *United Carbon Co.* v. *Binney & Smith Co.*, 317 U.S. 228, 63 S. Ct. 165, 87 L. Ed. 232 (1942); *Marshall* v. *Procter & Gamble Mfg. Co.*, 210 F. Supp. 619 (D. Md. 1962).

The phrase "knitting structure" is a term used to describe the direction the loops are pulled in relation to the fabric knitted. Basically there are three types of stitches: the flat, rib. and pearl stitches. A change in the knitting structure is obtained by changing the type stitch. The flat stitch is made by pulling all the loops to the base of the fabric; the rib stitch is made by pulling an even number of loops to the face of the fabric and an even number to the back of the fabric; and the pearl stitch is made by pulling all of the loops to the face of the fabric for a given number of courses and then pulling all the loops to the back of the fabric for a given number of courses.

It should be remembered that the defendants are attacking a patent duly considered and issued by the Patent Office, and that, therefore, a presumption of validity sur-

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[8] 35 U.S.C.A. § 112 provides in part:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The specifications shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. . . ."

rounds the patent. 35 U.S.C.A. § 282. Further, the commercial success is significant. While commercial success is no substitute for inventiveness, it is an important factor in a borderline case.

It appears to the Court, and the Court so finds as a fact, that the term "same knitting structure" is sufficiently definite that those skilled in the knitting art would be capable of determining the limits of the claim, and that considering the claim, in the light of the specifications, it reasonably informs those skilled in the art of its scope. The Court is of the opinion that it is not essential to validity to state the exact type stitch to be used to the exclusion of all others.

The statutory requirement of particularity and distinctness has been met in the Sarbo patent.

Infringement

Before the defendants can be found to have infringed the plaintiffs' patent, the plaintiffs must show that every essential element of the combination, or its equivalent, is embodied in the alleged infringing product.

Only defendants' styles 1334 A and 1334 C are accused of infringing. It appears that style 1334 B was not commercially produced by the defendants. There is no difference between styles 1334 A and 1334 C except that in style 1334 C the upper portion of the sock is made of lighter yarn with a shorter stitch than the lower portion, i.e., the lower portion is made of 70 denier yarn with less tension permitting a longer stitch while the upper portion is made of 50 denier yarn.

It is contended by the defendants that the change from the lighter yarn to the heavier yarn with less tension makes the sock fit better as there is more stretch.

This change is hardly perceptible to one not skilled in the art, and the Court regards this as an insignificant change.

Both of the accused styles, i.e., 1334 A and 1334 C, are made from a piece of seamless tubular fabric circular knitted without reciprocation. In both accused styles a rim is provided at the upper foot opening portion with rubber threads in the rim to hold the sock in place. In addition, when knitting is completed and before any further processing is done, both styles are symmetrical in form, sometimes commonly referred to as "pouch-like." After the knitting is completed, the lower portion is closed by knitting or seaming across the bottom. The only difference between style 1334 A and style 1334 C, as previously pointed out, a heavier yarn with less tension is knitted into the lower portion of the stock.

Hence, the same combination of elements is joined to form the defendants' styles 1334 A and 1334 C that is joined to make the foot sock of the plaintiffs, and the foot socks made pursuant to the patent in suit and the accused styles of the defendants are exactly the same unless the change to a heavier yarn with a longer stitch in defendants' style 1334 C effects a change in knitting structure.

The Court cannot find that changing from one weight or size yarn to another, using a different tension, effects a change in knitting structure. Such, in the opinion of the Court, does not avoid infringement.

It is concluded that the defendants' styles 1334 A and 1334 C infringe the plaintiffs' patent.

Liability of Individual Defendant, Paul Russell

The evidence is not persuasive that the defendant, Paul Russell, committed acts with such deliberateness as to make him individually liable. It is held that the defendant, Paul Russell, is not liable to the plaintiffs or either of them.

CONCLUSIONS OF LAW

1. The Court has jurisdiction of the parties.

2. This is an action arising under the patent laws of the United States, and the Court has jurisdiction of the subject matter by the terms of 28 U.S.C.A. § 1338(a).

3. Claim 3 of the Sarbo United States Patent No. 3,059,458 is valid for the reasons before stated.

4. Defendants' styles 1334 A and 1334 C infringe Claim 3 of the Sarbo United States Patent No. 3,059,458.

5. The individual defendant's motion to dismiss should be allowed.

6. Only in a case involving exceptional circumstances should the Court in the exercise of its discretion award attorney's fees. *Berry Brothers Corporation* v. *Siemon,* 4 Cir., 317 F. 2d 700 (1963). Such exceptional circumstances are not found in this case, and therefore, attorney's fees are not awarded.

7. The defendants have not knowingly and deliberately infringed Claim 3 of the plaintiffs' patent and have diligently and honestly sought to avoid infringement.

8. The plaintiffs are entitled to an accounting as to the defendants' manufacture of styles 1334 A and 1334 C, and upon motion by the plaintiffs, the Court will appoint a Master to determine the extent, if any, of plaintiffs' damages.

The foregoing opinion incorporates those findings of fact and conclusion of law deemed necessary by the Court for the disposition of the case. However, counsel may, of course, within the period provided by the Federal Rules of Civil Procedure submit requests for further or more specific findings or conclusions.

Counsel may agree upon a form of judgment conforming with this opinion.

EUGENE A. GORDON
United States District Judge

September 29, 1967

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1968

No. 806

WAYNE KNITTING MILLS and
THE MAY CORPORATION,

Petitioners

v.

RUSSELL HOSIERY MILLS, INC.,

Respondent

RESPONDENT'S BRIEF IN OPPOSITION TO THE PETITION FOR WRIT OF CERTIORARI

INTRODUCTORY STATEMENT

This is an ordinary and simple patent case involving a single patent claim. It presents no underlying fact issue, no conflict in decision between Courts of Appeals, no question of general interest or importance, and no question of law not already clearly resolved by prior decisions of the Supreme Court. It is merely a private suit between a purchaser of a patent and an alleged infringer, wherein the Petitioners (Plaintiffs below) now question whether the mandate regarding patent claims in the Patent Statute, 35 USC § 112, quoted in the next section, must be heeded. What Petitioners seek by their Petition is an overthrow of

the time-honored rule that each claim of a patent must contain language within its four corners clearly particularizing and distinguishing what is claimed from that which was obvious from the prior art. Concluding that Claim 3 of the SARBO patent in suit contained no language which could distinguish it from what was admittedly old and obvious, the Court of Appeals for the Fourth Circuit correctly held the claim invalid for overclaiming and failure to satisfy 35 USC § 112, without reaching the question of obviousness of the claimed product.

THE STATUTE INVOLVED

The relevant portions of the Statute, 35 USC § 112, on which the appellate court ruling of claim invalidity turned, and which the claim in issue failed to satisfy, details certain absolute requirements for patent specifications and claims as follows:

> "§ 112. Specification
>
> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims *particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.* * * *" (emphasis supplied)

QUESTIONS PRESENTED

The pivotal and only question presented by the Petition is whether, in a patent for a product, a patent reciting only admittedly old elements and having no language which particularizes the only aspect of the product which Petitioners regard as the supposed novelty over the prior art, thus failing to distinguish that which is claimed from "that which plaintiffs concede was not new", meets the statutory requirement of particularity and distinctness of 35 USC § 112.

ADDITIONAL STATEMENT OF THE CASE

Some additional details on the nature of the case need to be stated. Petitioner May, the party instrumental in bringing this infringement suit, had, independently of any knowledge of SARBO, developed and begun manufacture in 1963 of its socks alleged to now come under the SARBO patent more than a year prior to its purchase of the patent from another company who had bought the patent one month prior to such purchase. Petitioner May had been commercially making foot covers or shoe-top-length foot socks only since 1962.

Petitioners misleadingly represent, at page 4 of their Petition, that it is not clear just when Respondent first entered the foot cover field, whereas the record clearly shows that Respondent had been commercially producing shoe-top-length foot socks or foot covers since at least as early as 1954, four years prior to the development by SARBO of his patented foot sock. (DA 62-65, 213-215, and DX-19, 20 and 21)[1] In their characterization on page 3 of their

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[1] For convenience the parenthetical citations to the Petition, and to the appeal briefs and appendices which designated the parties by their initial titles, employ abbreviations as follows: DA - Defendant's Appendix; DX - Defendant's Exhibit; PB - Plaintiffs' (now Petitioners) Brief; Pet.B - Petitioners' Petition for Writ of Certiorari.

Petition of what was commercially available prior to SARBO, Petitioners notably fail to mention these socks of Respondent which had a circular seamless knit body with reciprocatorily knit heel and toe (for shaping) and elastic rims formed with *laid in rubber threads* (incorporated in the same way as in the rim of the patent in suit) to fit below the tops of many shoes then in use, such as nurses' shoes, oxfords, bowling shoes, golf shoes and sneakers. Petitioners admitted in their Court of Appeals Brief (PB 19) that this elastic rim of Respondent's 1954 socks fitted "below the ankle".

Claim 3 of the SARBO patent (the only claim in issue) defined the patented product merely as a knitted foot cover having three elements: (1) a seamless tubular rim "including at least some rubber threads", to form a foot entry opening, (2) a seamless tubular body of greater axial length than the rim and having the same knitting structure throughout its axial length and periphery, and (3) a seam at the bottom, to form a symmetrical pouch-like body. The Petitioners have always conceded, and both Courts below acknowledged, that each of these claimed elements were well known and had been disclosed in the prior art. The District Court had concluded, without recognizing its absence from the claim, that the only supposed inobviousness and possible new function in this assemblage of old elements was the specific location of the rubber-incorporating rim "below the ankle and entirely within the shoe", as the District Court thought those in the art could not grasp the idea "that rubber or elastic yarn could be laid in with proper tension to keep a below the ankle length sock on the foot" (274 F. Supp. 940, 941, DA-13, 15, Pet.B 33). In this, the District Court obviously overlooked the fact that Respondent's 1954 socks demonstrated that exactly this idea had been grasped and and this function put into practice in the prior art.

The Court of Appeals specifically recognized that prior art patents certainly disclosed each of the claimed elements in "knitted foot covers", identifying them at footnote 4 of its decision (Pet.B 32) as follows:

> "For example: (a) knitted foot covers made from symmetrically knit straight seamless tubes were disclosed by 1923 Teichmann British Patent No. 184,-470; 1922 Teichmann German Patent No. 362,040; 1923 Teichmann Swiss Patent No. 102,524; 1929 Teichmann U.S. Patent No. 1,724,784; 1932 Bellak U.S. Patent No. 1,841,518; 1944 Grey U.S. Patent No. 2,333,373; 1944 Herbert U.S. Patent No. 2,344,773; and 1946 Herbert U.S. Patent No. 2,400,692; (b) fabrication of the top or rim of tubular foot covers to cause them to hug or cling to the foot was taught by Teichmann British (a cord or lacing device), Bellak U.S. (plain stitch or laced-in elastic), and Grey U.S. and Herbert U.S. (knitted welts or double thickness fabric); (c) 1941 St. Pierre U.S. Patent No. 2,246,079 taught the use of laid-in rubber threads in the rims of various seamless circular knit socks and stockings."

Faced with Respondent's prior use and these prior patents, clearly refuting the District Court's statement of what was supposedly novel, the Petitioners urged in the Court of Appeals that the novelty in the SARBO sock lay, not merely in locating the rim in an area so broadly characterized as "below the ankle", but in the specific disposition of the rim so as "to fit below the instep" so that the product "covers *only* the toe, sole and heel portion of a wearer's foot" and is "hidden from view by a *low cut* ladies' shoe or slipper". (PB 4, 17) (Emphasis supplied) Their arguments in their Petition similarly predicate novelty only on this restricted rim location "below the instep". (Pet.B 10)

Without reaching the question of obviousness of this construction, the Court of Appeals applied the statutory standard of 35 USC § 112 to the claim and held it invalid, because of failure of the claim to particularize this location which Petitioners regard as the essential and only distinction over the prior art, stating:

> "From plaintiffs' argument and the district judge's conclusion, it is apparent that the lower location where the laid-in rubber rim serves its function is

> critical to the validity of Sarbo Claim 3, both as to inobviousness and new function. Yet the exact location of the rim is not identified anywhere in the claim."

The Court of Appeals focused sharply on the failure of the claim to include any restriction to confine the rim location "below the instep", stating: (Pet.B 33-34)

> "At most, the claim implies a location below the ankle, but plaintiffs and the court below predicate the validity of the claim, not on the entire area below the ankle, but on the undetermined location below the ankle where the ankle ceases to resemble the cylindrical conformation of the leg and exhibits the irregular configuration of the foot. Specifically, Sarbo Claim 3 gives no particularity as to the part or shape of the foot or leg portion the rim contacts against or where it is located relative to the instep."

The appellate court dismissed Petitioners' argument that the functional terminal phrase of the Claim provided any such limitation, stating: (Pet.B 34)

> "While this claim recites that the body does function as 'tip, sole and heel portions', absent is any language to exclude the body from also covering part of the instep, the ankle or parts of the foot in the area below the ankle."

ARGUMENT

Petitioners tacitly acknowledge that SARBO Claim 3 contains no express language limiting the rim location to the "below the instep" region which is the only novelty asserted for the product. The sum and substance of their argument is that the broad, generic term "foot cover" in the introductory phrase of the claim and the recital that the body functions to cover (at least) the tip, sole and toe, should be construed in light of the specification and the illustrative example shown in Figure 5, so as to limit the claim to "a structure which was located on the foot entirely below

the ankle and *below the instep* in such a manner as not to be visible above the shoe top". (Pet.B 8, 10) Significantly, Respondent's Style 1334 C, which was held by the District Court to infringe this Claim, has its rim located definitely up on the instep, rather than below the instep, as is revealed by the photograph at PA 208, and hence could not infringe if the Claim is limited, as Petitioners argue, to a below-the-instep rim. Furthermore, even the Petitioners' commercial foot cover is not covered by the Claim as so limited, since its rim also falls up on the instep, as the photograph at Pet. B iii clearly shows.

Repeatedly, Petitioners assert that the term "foot cover" in SARBO Claim 3 means a foot sock which is wholly concealed beneath the top of "the shoe". Their argument is based on the reference to the product as an "undersock" in the first sentence of the patent, and the illustration in Figure 5 of an example of one form the end product may take. But even if this argument is accepted, what Petitioners overlook, or avoid, is that no particular type of shoe is identified anywhere in the claims, the description, or the drawings, and in fact the word "shoe" does not even occur in the patent. Therefore, the crucial question arises, even if Petitioners' interpretation of "foot cover" is accepted to mean a "below the shoe-top foot cover": "What kind of shoe must the sock fit wholly within?" The specification is absolutely silent in this respect.

But significantly, the patentee elected to stand on Claim 3 without any reference to a shoe or any limitation whatsoever as to the type of shoe the foot cover would fit within. As thus drawn, the Claim applied with equal force to "foot cover" articles which fit below the top of and wholly within any shoe, even a high top shoe. Most certainly it applied to foot covers for many types of below-the-ankle shoes such as nurses' shoes, oxfords, bowling shoes, sneakers, golf shoes, etc., having its rubber-incorporating rim on, rather than below, the instep, just as the rim of Respondent's prior art 1954 foot covers. Clearly, therefore, the

Claim fails to particularize the location of the rim, even if construed to be below a shoe top, in any manner which would distinguish the location from what was already known in the prior art.

Petitioners cite many decisions containing general statements that, in certain cases, the specifications and drawings of a patent may be referred to as "an aid in interpreting the claims if the claims contain an ambiguity clarified by the specification or drawings", and assert that the term "foot cover" in SARBO Claim 3 is such an ambiguity. However, it must be remembered that the particularization of the rim location *below the instep* is absolutely essential to point out and distinguish the only thing which Petitioners assert to be novel about the patented product. Therefore, in this case, it is this absolutely essential detail (the rim location below the instep) which is **wholly** lacking from the claim and which Petitioners attempt to transfuse into the Claim from the specification and the illustrative example shown in Figure 5,[2] when the specification contains no mention of this rim location as the supposed departure from the prior art.

It is noteworthy that, during the entire prosecution history of the application for this patent, the rubber-incorporating rim and its location were considered to be of no patentable moment whatsoever. The file history shows that the Patent Office steadfastly insisted, without ever retreating from this position (DA 170-171, 175-176, 181), and the patentee conceded, that the provision of the rubber-incorporating rim in the foot cover was obvious and well known from certain prior art patents. The patentee said in this regard: (DA 185)

> "It has been admitted at said interview, that the incorporation of an elastic yarn into knitting fabrics

[2]Certainly the illustration of one example of a form the end product may take cannot cure the deficiencies of a claim which fails to particularize any novelty, as recognized in a number of decisions: Consolidated Bunging Apparatus Co. v. Metropolitan Brewing Co., 60 Fed. 93, 95 (2 Cir. 1894); Wheeler et al. v. James, 189 Fed. 896, 902 (E.D.N.Y. 1911); Dugan v. Lear, Inc., 156 F.2d 29, 31 (2 Cir. 1946).

> is known per se and does not have any specific bearing on the present invention."

In fact, the Patent Office called for a full disclosure of how the rubber threads were incorporated with proper tension in the rim, if the patentee deemed this to be a feature of any novelty in his product, and the patentee declined to supply such a description on the express ground that the tension of the rubber threads was regulated in the same manner commonly used in making conventional socks or short socks. (DA 179)

Not one of the prior decisions cited by Respondents presents any authority for relying **wholly** upon resort to specification or drawings to supply to a patent claim, which otherwise described only what was conceded to be obvious or known, the **critical and only feature** which was asserted to constitute any distinction over the prior art. For the most part, the appellate and trial court decisions cited by Petitioner reveal that the claims by their own language already distinguished and particularized the patented subject matter from the prior art without regard to the term to be clarified by the specification or drawings[3], and in some of the cited decisions, the quoted statements related only to the issue of infringement, not validity, or to adequacy of the specification disclosure.[4] And wherever the specification was referred to for clarification of any claim terms, the patents, unlike the SARBO patent, contained extensive descrip-

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[3]Particularly Yosemite Chemical Co. v. United States, 360 F.2d 948 (Ct. Cl. 1966); Lincoln Stores v. Nashua Mfg. Co., 157 F.2d 154 (1 Cir. 1946); Wyott Manufacturing Co. v. Doran Coffee Roasting Co., 160 F. Supp. 644 (D. Col. 1958); Jones Knitting Corp. v. Morgan, 361 F.2d 451 (3 Cir. 1966); and H. H. Robertson Co. v. Klauer Mfg. Co., 98 F.2d 150 (8 Cir. 1938).

[4]Steiner and Voegtly Hardware Co. v. Tabor Sash Co., 178 Fed. 831 (C.C.N.J. 1910); Illinois Tool Works, Inc. v. Brunsing, 389 F.2d 38 (9 Cir. 1968); Del Francia v. Stanthony Corp., 278 F.2d 745 (9 Cir. 1960); Victor Cooler Door Co. v. Jamison Cold Storage Door Co., 44 F.2d 288 (4 Cir. 1930).

tions in the specifications identifying the things signified by that term as one of the novel departures over the prior art.

Of the Supreme Court decisions cited by Petitioners, the claims in *United States v. Adams*, 383 U.S. 39, 86 S. Ct. 708, 15 L. Ed. 2d 572 (1966), already distinguished over the prior art by reciting the magnesium and fused cuprous chloride electrodes, without requiring any restriction by interpretation to their use with a "water electrolyte" and additionally the specification had expressly emphasized that water alone could be used. In *Exhibit Supply Company v. Ace Patents Corporation*, 315 U.S. 126, 62 S. Ct. 513, 86 L. Ed. 736 (1942), there was not even an issue of validity in the case, and reference was had to the specification and drawings merely to clarify the permissible scope of the term "embedded" on the issue of infringement.

In *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U.S. 47, 59 S. Ct. 8, 83 L. Ed. 34 (1938), reference to the drawings was had only to determine whether they might support introduction of added description by amendment to the specification and to the claims, and is no authority for resorting to the drawings to supply limitations to claims which do not already particularize and distinguish the invention.

Graver Tank & Manufacturing Co. v. Linde Air Products Co., 336 U.S. 271, 69 S. Ct. 535, 93 L. Ed. 672 (1949), and *Permutit Co. v. Graver Corporation*, 284 U.S. 52, 52 S. Ct. 53, 76 L. Ed. 163 (1931), cited by Petitioners thoroughly support, rather than contradict, the Court of Appeals' decision in the present case, and are significant for the immediately adjacent or intervening language omitted from Petitioners' quotations. In the *Graver Tank* decision, immediately preceding the language quoted at Pet.B 16, this Court said:

> "While vain repetition is no more to be encouraged in patents than in other documents, and claims like other statements may incorporate other matter by reference, *their text must be sufficient to 'particu-*

> *larly point out and distinctly claim' an identifiable invention or discovery*. We have frequently held that it is the claim which measures the grant to the patentee." (emphasis added)

The *Graver Tank* decision is significantly analogous to the present case, and thoroughly sustains the determination that SARBO Claim 3 could not be limited or qualified by the specification to mean only a foot cover whose rim lies below the instep, as the Supreme Court there agreed with the District Court decision that the terms "silicates" and "metallic silicates" in two of the claims could not be limited or qualified by the specification to mean only the nine metallic silicates which has been proved operative and that these claims were therefore invalid.

The language omitted in Petitioners' quotation from the *Permutit* case, at Pet.B 16, pointed to the indispensable function which patent claims must serve in apprising the public of the limits of the patented monopoly, stating:

> "The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains, may construct and use it after the expiration of the patent, but also to *inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.*" (emphasis supplied)

Obviously, SARBO Claim 3 cannot inform the public of the limits of the patent monopoly when it fails to identify the assertedly novel location of the rim and in no way restricts the type of shoe for which the foot cover should serve as an undersock.

The impropriety of relying upon the specification, rather than the language of the claims themselves, to supply the required particularity and distinctiveness was recognized in *McCarty v. Lehigh Valley Railroad Co.*, 160 U.S. 110, 116,

16 S. Ct. 240, 40 L. Ed. 358 (1895), cited in the *Permutit* decision, where this Court said:

> "There is no suggestion in either of these claims that the ends of the bolster rest upon springs in the side trusses, although they are so described in the specification and exhibited in the drawings. It is suggested, however, that this feature may be read into the claims for the purpose of sustaining the patent. While this may be done with a view of showing the connection in which a device is used, and proving that it is an operative device, we know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in the claim in order to limit such claim and avoid a defense of anticipation, we should never know where to stop."

In deciding that SARBO Claim 3 clearly failed to satisfy the requirements of particularity and distinctness imposed by 35 USC § 112, the Court of Appeals did not violate any principles of law enunciated by this Court. On the contrary, the Court of Appeals applied the statutory criterion to the SARBO Claim in a manner thoroughly consistent with, and in the only manner which would be consistent with, the principles laid down by this Court in the decisions referred to above, and the express interpretations of the statute given in *United Carbon Co. v. Binney & Smith Co.*, 317 U.S. 228, 63 S. Ct. 165, 87 L. Ed. 232 (1942), and *General Electric Co. v. Wabash Appliance Corp. et al.*, 304 U.S. 364, 58 S. Ct. 899, 82 L. Ed. 1402 (1938). In the *United Carbon* case, this Court extensively discussed § 4888 of the Revised Statute, which was the predecessor of 35 USC § 112, stating: (317 U.S. 232)

> "Section 4888 of the Revised Statutes, 35 USCA § 33, requires that the applicant for a patent 'shall particularly point out and distinctly claim the part, improvements, or combination which he claims as his invention or discovery.' As the Court recently

stated in General Electric Co. v. Wabash Appliance Corp., 304 U.S. 364, 369, 82 L. Ed. 1402, 1405, 1406, 58 S. Ct. 899:

> 'Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirements as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must 'inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' The claim 'measure the invention.' . . . In a limited field the variant must be clearly defined.'"

The paramount public interest in strict insistence upon this statutory requirement was recognized with the statement at 317 U.S. 233:

> "* * * To sustain claims so indefinite as not to give the notice required by the statute would be in direct contravention of the public interest which Congress therein recognized and sought to protect. Cf. Muncie Gear Works v. Outboard Marine & Mfg. Co., 315 U.S. 759, 86 L. Ed. 1171, 62 S. Ct. 865."

The practical importance of adhering to this statutory requirement was emphasized with the statement: (317 U.S. 236)

> "The statutory requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise. A zone of uncertainty which enterprise and experimentation may enter only at the risk of infringement claims would discourage invention only a little less than unequivocal

> foreclosure of the field. Moreover, the claims must be reasonably clearcut to enable courts to determine whether novelty and invention are genuine."

In the *General Electric* case, this Court preceded the language earlier quoted in *United Carbon* with the statement: (304 U.S. 368)

> "The statute has another command. Recognizing that most inventions represent improvements on some existing article, process or machine, and that a description of the invention must in large part set out what is old in order to facilitate the understanding of what is new, Congress requires of the applicant 'a distinct and specific statement of what he claims to be new, and to be his invention.'"

Pertinent to Petitioners' assertion that the functional terminal phrase of SARBO Claim 3 identifies some parts of the foot which the foot cover would cover, this Court in the *General Electric* case pointed out that a claim cannot be justified by such terms, stating: (304 U.S. 372)

> "But Congress requires, for the protection of the public, that the inventor set out a definite limitation of his patent; that condition must be satisfied before the monopoly is granted. * * * The difficulty of making adequate description may have some bearing on the sufficiency of the description attempted, but it cannot justify a claim describing nothing new except perhaps in functional terms."

To like effect is this Court's statement in *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1, 9, 67 S. Ct. 6, 91 L. Ed. 3 (1946). The last paragraph of 35 USC § 112, quoted at Pet.B 12, at most only says that a means plus function phrase may be construed "to cover" what is described in the specification "and equivalents thereof" but does not say the phrase shall be *limited* to that construction. It certainly does not authorize limitation of the terminal functional clause in SARBO Claim 3 to the exact rim location shown in the drawings, especially when that clause

only means that the body covers *at least* the tip, sole and toes of the foot. See *In re Teague*, 254 F.2d 145, 151 (C.C.P.A. 1958).

This Court's decisions make clear that 35 USC § 112 assigns to the **claims**, not to the specification or drawings, the indispensable function of particularizing and distinguishing what is patented from what is obvious from the prior art, so that the *public* is clearly informed of the limits of the asserted monopoly. It is the protection of the *public* which is paramount and necessitates rigid adherence to this statutory command. The extent to which Petitioners labor in their brief to construct from the SARBO specification, which says nothing indicating that rim location below the instep is regarded as a novel feature, an implied limitation to such location in the Claim, which also says nothing about rim location, emphasizes the unreasonable burden which the public would face in trying to ascertain the limits of the patent claim. A hopeless state of uncertainty and indefiniteness would result, which this statute is specifically designed to avoid, as the public cannot, and should not, be called upon to foresee what possible distortions of the claims may be made from the specification when the claims themselves do not particularize the limit of the patent monopoly.

In light of this Court's decisions, the Court of Appeals was clearly right in the present case in pointing to its own prior statement in *Triumph Hosiery Mills, Inc. v. Almance Industries, Inc.*, 299 F.2d 793, 801 (4 Cir. 1962), *cert. denied*, 370 U.S. 924, 82 S. Ct. 1566, 8 L. Ed. 2d 504 (1962), wherein it recognized that:

> "The uncertainties and confusion arising from such a patent would be intolerable. Infringement would be difficult to judge, for just when the patentees' manufacture was within or without the patent would not be readily apparent to a competitor."

Since SARBO Claim 3 fails to identify in any way the rim location, and thus does not make known the rim location limits of the monopoly purported to be granted, the Claim certainly fails to meet the statutory mandate of particularity and distinctness and is fatally defective. Whether patent claims could, in appropriate circumstances, be limited by a resort to patent specifications which clearly delineate a novel feature signified by the language in the claims is not in issue here, as the SARBO specification, like Claim 3, fails to specify and circumscribe any particular rim location. Hence, the Court of Appeals correctly concluded that: (Pet. B 34-35)

> "* * * by the breadth of the claim that which is conceded to have been known in the prior art - that which the prior art anticipated or made obvious - is included within the claimed invention; hence, the claim is invalid for overclaiming. * * *
>
> "It follows, also, that by failure to specify the critical location of the laid-in rubber rim the claim of the patent is invalid for failure to satisfy 35 USC § 112."

CONCLUSION

Respondents respectfully submit that the decision reached by the Court of Appeals was entirely just and involves no error or misapplication of the law, nor conflict between decisions of different Courts of Appeal, nor any question of possible interest or importance which should absorb the time of this Court.

It is submitted that the public interest has been served by the holding of the Court of Appeals that the patent claim in suit is invalid, and that the Petition is wholly without merit and should be denied.

Respectfully submitted,

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